

This Opinion is not a
Precedent of the TTAB

Mailed: December 1, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Fair Isaac Corporation
v.
FIDO Alliance, Inc.

—
Opposition No. 91225634 (Parent Case)
consolidated with
Opposition No. 91249276
Cancellation No. 92071706
—

Timothy M. Kenny, Norton Rose Fulbright US LLP,
for Fair Isaac Corporation (Opposer/Petitioner).

John C. Cain, Munck Wilson Mandala, LLP,
For FIDO Alliance, Inc. (Applicant/Respondent).

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Before Bergsman, Heasley, and Casagrande,
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:

This consolidated proceeding primarily concerns likelihood of confusion claims involving the marks FICO and FIDO.

I. The Proceedings and the Marks At Issue

A. Opposition No. 91225634

FIDO Alliance, Inc. (“Applicant”) filed three Principal Register applications on February 10, 2015, all under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to register the marks FIDO (standard characters),¹ **fido** (stylized),² and **fido** (stylized),³ all of which identify the following goods and services:

Biometric sensors for enabling authentication of personal identity in conjunction with account management computer software; Systems comprising computer hardware and software for enabling authentication of the personal identity of computer users; Electronic security token in the nature of a fob-like device used by an authorized user of a computer system to facilitate authentication; Systems comprising computer hardware and software for enabling USB, near field communication (NFC), or wireless low energy technology as a transport for authenticating users between computer devices; Computer software to automate account management entry and retrieval by enabling authentication of personal identity using biometric, second factor, wireless low energy technology, or NFC information; Second factor identity authentication devices, namely, USB, NFC or wireless low energy technology computer access control keys, in International Class 9; and

¹ Application No. 86530254 (the “’254 Application”). For the Class 9 goods, the claimed date of first use of and first use in commerce is March 31, 2013, and for the Class 45 services, the claimed date of first use is February 15, 2013, with a date of first use in commerce of March 31, 2014.

² Application No. 86530299 (the “’299 Application”) (color not claimed as part of the mark) For the Class 9 goods, the claimed date of first use of and first use in commerce is March 31, 2013, and for the Class 45 services, the claimed date of first use is February 15, 2013, with a date of first use in commerce of October 8, 2014.

³ Application No. 86530417 (the “’417 Application”) contained a statement claiming color as part of the mark as follows: “The color(s) black and yellow-orange is/are claimed as a feature of the mark.”). For the Class 9 goods, the claimed date of first use of and first use in commerce is March 31, 2013, and for the Class 45 services, the claimed date of first use is February 15, 2013, with a date of first use in commerce of October 8, 2014.

Providing user authentication services in online transactions and e-commerce transactions; Providing a secure binding process from a user device to a server backend for assured user authentication, in International Class 45.

Fair Isaac Corporation (“Opposer”) opposed all three applications on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).⁴ In Opposition No. 91225634, Opposer pleaded ownership of the following registered Principal Register marks⁵:

- Reg. No. 2273432 (renewed) for FICO in “typeset word” format⁶ for services identified as “consultation services in the field of financial information, namely, providing credit [storing] *scoring* services” (claiming dates of first use and first use in commerce of Nov. 8, 1995);⁷
- Reg. No. 2573131 (renewed) for FICO in “typeset word” format for services identified as:

Business information services; information storage and retrieval in the field of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, portfolio management,

⁴ See 1 TTABVUE in Opposition No. 91225634. Citations in this opinion to filings in proceedings before the Board are to TTABVUE, the Board’s online docketing system. Unless otherwise noted, all TTABVUE cites will be to the ’634 Opposition, which is the parent proceeding. The number preceding “TTABVUE” corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry, as paginated by TTABVUE, where any specifically cited portions of the document appear.

⁵ Opposer also pleaded ownership of Application No. 86234484 and Reg. No. 3958542, but no longer asserts any claim based on these marks because, while this proceeding was pending, the application was abandoned and the registration was canceled.

⁶ Before November 2, 2003, standard character marks used to be known as “typed” or, sometimes, “typeset” marks. On November 2, 2003, the pertinent rule was amended, and since then marks in typed or typeset format are referred to as “standard character marks,” to comply with the Madrid Protocol Implementation Act of 2002. See 68 FR 55748, 55755 (Nov. 2, 2003); Trademark Manual of Examining Procedure (TMEP) § 807.03 (2023).

⁷ The Status page for this registration in the USPTO’s electronic Trademark Status & Document Retrieval (TSDR) database indicates that the identification of services was amended to delete the bracketed term “storing” and replace it with the asterisked term “scoring.”

communications management and data management; statistical forecasting and analysis; business consultation, preparing business reports and management consultation, in International Class 35 (claiming dates of first use and first use in commerce of Nov. 1995);

Financial analysis and consultation; financial information provided by electronic means; risk management; consultation on debt recovery and collection, in International Class 36 (claiming dates of first use and first use in commerce of Nov. 1995); and

Education and training in the field of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, portfolio management, communications management and data management, in International Class 41 (claiming dates of first use and first use in commerce of Nov. 1995).

- Reg. No. 2714565 (renewed) for MYFICO in “typeset word” format for services identified as:

Providing business information services in the fields of modeling, scoring, and analytics, credit risk management, and statistical forecasting and analysis, in International Class 35;

Financial analysis and consultation; financial information provided by electronic means; credit risk management, in International Class 36;

Educational services, namely, conducting e-mail, website, public educational forums, and conferences in the use of scoring and analytics, and credit risk management, in International Class 41; and

Data mining and data warehousing services, namely, using proprietary software to evaluate, analyze, and collect data for use in modeling, scoring, and analytics, and credit risk management [; providing online newsletters in the fields of modeling, scoring, and analytics], in International Class 42.⁸

⁸ The claimed dates of first use and first use in commerce for all services was March 2001.

- Reg. No. 2989390 (renewed) for FICO in standard character format for goods identified as “Computer software in the field of credit scoring for use in creating and implementing business decision processes, risk management, evaluating credit ratings, score computation, score strategy and management and credit marketing in the field of financial services, insurance, telecommunications and retail industries,” in International Class 9 (claiming dates of first use and first use in commerce of March 2004);
- Reg. No. 4032019 for FICO (renewed) in standard characters for the following goods and services:

Computer software in the field of credit scoring for use in creating and implementing business decision processes, risk management, evaluating credit ratings, score computation, score strategy and management and credit marketing; computer software for use in credit application processing; computer software for account management; computer software for use in rendering business and financial information; graphical user interface software for use with various database software; computer software which acts as a decision support system for determining account origination; software and enterprise software applications for use in monitoring, tracking, detecting, preventing and managing fraud in credit transactions, identity theft and other types of fraud in connection with credit grantors, financial and lending institutions, and insurance companies, insurance providers and insurance payors; scorecard development, score computation, scorecard management and strategy support software for use in making credit, lending and insurance decisions; computer programs in the field of investment and risk analysis for financial institutions, namely, asset and liability analysis of current performance measurements and risk management projections and queuing and case management software; computer software for business applications for use in automation, management and maintenance of business rules and business policies; software for predictive modeling, business rules management, business rules execution and design of business rules and strategy trees, all for use in business decision automation and control systems; providing downloadable online newsletters in the fields of modeling, scoring, and analytics, financial information, risk analysis, risk management, credit scoring, credit management, and statistical and economic forecasting and analysis, fraud, and business decision processes and management, in International

Class 9 (claiming dates of first use and first use in commerce of March 2004);

Printed publications, namely, user manuals for computer software, customer training manuals, research publications and newsletters, all in the field of financial information and risk analysis; publications and printed materials, namely, brochures, booklets, manuals, pamphlets, periodicals, newsletters, leaflets, informational sheets, and guides in fields of modeling, scoring, and analytics, financial information, risk analysis, risk management, credit scoring, credit management, and statistical and economic forecasting and analysis, fraud, and business decision processes and management, in International Class 16 (claiming dates of first use and first use in commerce of March 2004);

Computerized database management; business information services; economic and statistical forecasting and analysis; business consultation; preparing business reports and management consultation; data marketing services, namely, providing statistical reports and marketing data evaluation for others by means of computer; providing statistical information for mortgage eligibility through a rating system; business services, namely, providing predictive modeling in the fields of marketing strategies, marketing communications and marketing campaigns; providing predictive modeling services to facilitate customer risk assessment and customer account management, in International Class 35 (claiming dates of first use and first use in commerce of Nov. 1995);

Credit scoring services; credit risk management services; financial analysis and consultation; financial information provided by electronic means; providing information in the fields of credit rating in the nature of modeling, scoring and analytics; financial risk management; financial portfolio management; providing information about credit scores and credit management; financial management; consultation on debt recovery and collection; financial and insurance risk analysis services, namely, scorecard development, computation and management; evaluating credit risks through use of algorithms; evaluation of credit risk data to determine mortgage risk; evaluating credit bureau data for credit grantors, financial and lending institutions, insurance companies, insurance providers and insurance payors; credit bureau score updating services;

small business credit risk scoring services; consultation services in the field of financial information; financial consulting services in the field of portfolio risk and profits for consumer credit lenders, namely, product planning, account acquisition, management and collections, and management information system and organizational structure; information services in the field of credit scoring, customer credit evaluation and customer collections, in International Class 36 (claiming dates of first use and first use in commerce of Nov. 8, 1995);

Educational services in the field of risk management for consumer credit lenders, namely, conducting seminars and in-house training; education and training in the fields of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, credit risk management, portfolio management, communications management and data management in the nature of classes, seminars and workshops; educational services, namely, conducting classes, seminars, and conferences in the nature of creation and execution of business decision processes using analytical models, data management and software for marketing, customer management and business management; educational services, namely, conducting e-mail, website, public educational forums, and conferences in the use of scoring and analytics, and credit risk management; educational services in the field of risk management for consumer credit lenders, namely, the conducting of seminars and in-house training; providing online newsletters in the fields of modeling, scoring, and analytics, financial information, risk analysis, risk management, credit scoring, credit management, and statistical and economic forecasting and analysis, fraud, and business decision processes and management, in International Class 41 (claiming dates of first use and first use in commerce of Nov. 1995);

Computer programming and software design and development; computer systems analysis and consultation; web-hosting services; data mining and data warehousing services, namely, using proprietary software to evaluate, analyze and collect data for use in modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, credit risk management, portfolio management, communications management and data management; providing temporary use of

online non-downloadable software for use in accessing and searching databases in the fields of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, credit risk management, portfolio management, communications management and data management; providing temporary use of on-line non-downloadable software for business applications for use in automation, management and maintenance of business rules and business policies; providing temporary online use of non-downloadable software for predictive modeling in the fields of customer marketing, customer business strategy decisions, customer account management and customer risk assessment; providing temporary use of online non-downloadable software for use in monitoring, tracking, detecting, preventing and managing fraud in credit transactions, identity theft and other types of fraud in connection with credit grantors, financial and lending institutions, and insurance companies, insurance providers and insurance payors; providing temporary use of online non-downloadable software for predictive modeling, business rules management, business rules execution and design of business rules and strategy trees, all for use in business decision automation and control systems; development of customized software for others for use in monitoring, tracking, detecting, preventing and managing fraud; business information searching and retrieval in the field of modeling, scoring and analytics, credit risk management, risk management, marketing and solicitation, account origination, account management and customer management, portfolio management, communications management and data management for others, in International Class 42 (claiming dates of first use and first use in commerce of March 2002); and

Fraud detection services using data warehousing, data mining and predictive modeling software, all for use in monitoring, tracking, detecting, preventing and managing fraud and identity theft in the fields of credit fraud, credit card fraud, debit card fraud, check fraud, identity theft, mortgage fraud, and banking fraud, in International Class 45 (claiming dates of first use and first use in commerce of March 10, 2009).

Applicant filed an answer denying the salient allegations in the notice of opposition.⁹

B. Opposition No. 91249276

While Opposition No. 91225634 was pending, Applicant, on September 17, 2018, filed Application Ser. No. 88120383 to register **fido** for the following identified goods and services:

Authentication devices in the nature of electronic fob-like devices and biometric devices for use by an authorized user of a computer system to facilitate authentication; computer software for authentication of user identification and device attestation; Computer software for authentication of user identification and device attestation, in International Class 9;

Association services, namely, promoting the development, use of, and compliance with standards for authentication and device attestation, in International Class 35;

⁹ See 48 TTABVUE. Under the heading “Affirmative Defenses,” Applicant includes an allegation that the Notice of Opposition fails to state a claim upon which relief can be granted and fails to state an adequate basis for some or all of its claims. *Id.* at p. 6 ¶¶ 2 & 3. These are not affirmative defenses. See, e.g., *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *3 n.5 (TTAB 2022) (failure to state a claim is not an affirmative defense). Under the same heading, Applicant also alleges that there is no likelihood of confusion. 48 TTABVUE 6 ¶1. This is just an amplification of Applicant’s denial of Opposer’s allegations, not an affirmative defense. See, e.g., *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *3-4 (TTAB 2021); see generally *Germain v. US Bank Nat’l Ass’n*, 920 F.3d 269, 273 n.14 (5th Cir. 2019) (an affirmative defense “assumes the plaintiff proves everything he alleges and asserts, even so, the defendant wins”) (citation omitted). Applicant also claims to “reserve[] the right to assert all defenses disclosed or developed in the course of discovery or trial.” 48 TTABVUE 6 ¶ 4. This is neither an affirmative defense nor proper. See *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *6 (TTAB 2022) (Applicant’s “attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give ... [Applicant] fair notice of such defenses.”) (citations omitted). Applicant also pleaded estoppel and acquiescence. 48 TTABVUE 6 ¶ 5. Estoppel and acquiescence are valid affirmative defenses, see, e.g., 15 U.S.C. § 1069, but because Applicant did not pursue them at trial, they are forfeited, and we do not address them. See, e.g., *In re Google Techs. Holdings, LLC*, 980 F.3d 858, 2020 USPQ2d 11465, at *3-4 (Fed. Cir. 2020) (argument not pursued is forfeited).

Financial transaction services, namely, providing secure commercial transactions in the nature of authentication of user identification and device attestation services for authorizing financial transactions, in International Class 36; and

Providing user authentication and device attestation backend services using public-key cryptographic technology in e-commerce transactions; computer security services, namely, providing a secure binding process between a device and a backend server for authentication of user identification and device attestation; computer security services in the nature of authentication of user identification and device attestation services for authorizing financial transactions, in International Class 42.¹⁰

On July 3, 2019, Opposer filed a notice of opposition against the mark in the '383 ITU Application, asserting ownership of the same FICO standard character registrations described in detail above: Reg. Nos. 2273432, 2573131, 2714565, 2989390, and 4032019.¹¹ It also asserted ownership of Application Ser. No. 88230457 for ULTRAFICO in standard characters,¹² which on November 15, 2022, matured into Reg. No. 6901439, for the following goods and services:

Computer software in the field of credit scoring for use in creating and implementing business decision processes, risk management, evaluating credit ratings, score computation, score strategy and management and credit marketing; scorecard development, score computation, scorecard management and strategy support software for use in making credit, lending and insurance decisions; computer programs in the field of investment and risk analysis for financial institutions, namely, asset and liability analysis of current performance measurements and risk management projections and queuing and case management software; providing downloadable

¹⁰ Application No. 88120383 (the “'383 ITU Application”) was filed based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The '383 ITU Application describes the mark as follows: “The mark consists of the letters ‘fido’ in lower case with the ‘i’ stylized in the form of a human being with an arm extended to the left.”

¹¹ See 1 TTABVUE in Opposition No. 91249276.

¹² See *id.*

online newsletters in the fields of modeling, scoring, and analytics, financial information, risk analysis, risk management, credit scoring, credit management, and statistical and economic forecasting and analysis; computer software in the field of credit scoring for use in creating and implementing business decision processes, risk management, evaluating credit ratings, score computation, score strategy and management and credit marketing in the field of financial services, insurance, telecommunications and retail industries, in International Class 9;

Publications and printed materials, namely, brochures, booklets, manuals, pamphlets, periodicals, newsletters, leaflets, informational sheets, and guides in fields of modeling, scoring, and analytics, financial information, risk analysis, risk management, credit scoring, credit management, and statistical and economic forecasting and analysis, in International Class 16;

Computerized database management; business information services; economic and statistical forecasting and analysis; preparing business reports and management consultation; data marketing services, namely, providing statistical reports and marketing data evaluation for others by means of computer; providing statistical information for mortgage eligibility through a rating system; business services, namely, providing predictive modeling in the fields of marketing strategies, marketing communications and marketing campaigns; providing predictive modeling services to facilitate customer risk assessment and customer account management, in International Class 35;

Credit scoring services; credit risk management services; financial analysis and consultation; financial information provided by electronic means; providing information in the fields of credit rating in the nature of modeling, scoring and analytics; financial risk management; financial portfolio management; providing information about credit scores and credit management; financial management; financial and insurance risk analysis services, namely, scorecard development, computation and management; evaluating credit risks through use of algorithms; evaluation of credit risk data to determine mortgage risk; evaluating credit bureau data for credit grantors, financial and lending institutions, insurance companies, insurance providers and insurance payors; credit bureau score updating services; small business credit risk scoring services; information services in the field of credit scoring, customer credit evaluation and customer collections; consultation services in the field of financial

information; financial consulting services in the field of portfolio risk and profits for consumer credit lenders, namely, product planning, account acquisition, management and collections, and management information system and organizational structure, namely, providing credit scoring services, in International Class 36;

Educational services in the field of risk management for consumer credit lenders, namely, conducting seminars and in-house training; education and training in the fields of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, credit risk management, portfolio management, communications management and data management in the nature of classes, seminars and workshops; educational services, namely, conducting classes, seminars, and conferences in the nature of creation and execution of business decision processes using analytical models, data managements and software for marketing, customer management and business management, educational services, namely, conducting e-mail, website, public educational forums, and conferences in the use of scoring and analytics, and credit risk management; educational services in the field of risk management for consumer credit lenders, namely, the conducting of seminars and in-house training; providing online newsletters in the fields of modeling, scoring, and analytics, financial information, risk analysis, risk management, credit scoring, credit management, and statistical and economic forecasting and analysis, fraud, and business decision processes and management; education and training in the field of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, portfolio management, communications management and data management, namely, conducting workshops and seminars, in International Class 41; and

Computer programming and software design and development; computer systems analysis and consultation; web-hosting services; data mining and data warehousing services, namely, using proprietary software to evaluate, analyze and collect data for use in modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, credit risk management, portfolio management, communications management and data management; providing temporary use of online non-downloadable software for use in accessing and searching databases in the fields of modeling, scoring and analytics, marketing and solicitation, account origination,

account management and customer management, risk management, credit risk management, portfolio management, communications management and data management; providing temporary online use of non-downloadable software for predictive modeling in the fields of customer marketing, customer business strategy decisions, customer account management and customer risk assessment; business information searching and retrieval in the field of modeling, scoring and analytics, credit risk management, risk management, marketing and solicitation, account origination, account management and customer management, portfolio management, communications management and data management for others; computerized business information storage and retrieval in the field of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, portfolio management, communications management and data management, in International Class 42.¹³

Similar to the first-filed opposition, this opposition alleges priority and likelihood of confusion under Trademark Act Section 2(d).¹⁴

In its Answer, Applicant denies the salient allegations in the Notice of Opposition.¹⁵

C. Cancellation No. 92071706

Applicant also owns three registrations that issued before it filed the applications set forth above:

- Reg. No. 4679315, issued on January 27, 2015, for FIDO in standard character format for services identified as “Association services, namely,

¹³ As to all goods and services, this registration claims a date of first use of October 22, 2018 and a date of first use in commerce of April 1, 2022.

¹⁴ See 1 TTABVUE 2 in Opp. No. 91249276

¹⁵ See 5 TTABVUE in Opp. No. 91249276. The Answer contains a section entitled “Affirmative Defenses” that contains allegations substantively identical to those in Opp. No. 91225634. See *id.* at 6. Our prior comments about these allegations, see *supra*, n.9, apply equally here, except that we note that in its Answer in the ’276 Opposition, Applicant also mentions the defense of laches, which, if pleaded properly and proved, is a viable affirmative defense. Applicant, however, did not pursue laches at trial, so it is forfeited. See, e.g., *Google Techs. Holdings*, 2020 USPQ2d 11465, at *3-4.

promoting the interests of a business network of others to facilitate and protect digital secure transmission of personal information, social networking, online commerce, and privacy; promoting public awareness of the need for a standard protocol and interface definition for a secure business network of others; promoting public awareness of the need for the interoperability of and a certification program for a secure business network of others,” in International Class 35 (claiming a date of first use of Aug. 31, 2012, and first use in commerce of February 28, 2013);¹⁶

- Reg. No. 4682450, issued on February 3, 2015, for FIDO in standard character format for services identified as “Providing user authentication services in e-commerce transactions, namely, providing a secure binding process from a user device to a server backend for assured user authentication,” in International Class 45 (claiming a date of first use of February 15, 2013, and first use in commerce of October 8, 2014);¹⁷ and
- Reg. No. 5141976, issued on February 14, 2017, for FIDO in standard character format for goods identified as “computer software, namely, software to automate service account password management and retrieval by enabling authentication of personal identity using biometric information; near field communication (NFC) technology-enabled readers and devices, namely, mobile phones; USB computer access control keys; electronic key cards,” in International Class 9 (claiming a date of first use and first use in commerce of 2014).¹⁸

All three of Applicant’s registrations matured from applications filed on October 22, 2015.

On the same day it filed the second opposition proceeding (Opp. No. 91249276), Opposer also filed a petition to cancel these three FIDO registrations.¹⁹ Opposer asserts ownership of the same marks (Reg. Nos. 2273432, 2573131, 2714565, 2989390, and 4032019, and Application Ser. No. 88230457 for ULTRAFICO (now

¹⁶ Section 8 declaration of continued use accepted on April 30, 2020.

¹⁷ Section 8 declaration of continued use accepted on May 26, 2020.

¹⁸ Section 8 declaration of continued use accepted on September 14, 2023.

¹⁹ See 1 TTABVUE in Canc. No. 92071706.

Reg. No. 6901439)) as in the '276 Opposition and similarly alleges priority and likelihood of confusion.²⁰

In its Answer, Applicant (Respondent in this cancellation proceeding²¹) denies the salient allegations in the Petition.²²

D. Consolidation

On September 23, 2019, the Board consolidated the second-filed opposition proceeding (No. 91249276) with the earlier-filed opposition proceeding (No. 91225634), designating the earlier-filed opposition proceeding as the parent case.²³ A few days later, the Board added Cancellation No. 92071706 as another child to the consolidated proceedings.²⁴

In the consolidated proceeding, both parties filed trial briefs, and Opposer filed a reply brief.²⁵ The consolidated cases are now ready for decision.

²⁰ *See id.*

²¹ For simplicity's sake, this opinion will call FIDO Alliance, Inc., "Applicant" and Fair Isaac Corporation "Opposer" throughout, even though Fair Isaac is technically the "petitioner" and FIDO Alliance the "respondent" in the '706 Cancellation.

²² *See* 4 TTABVUE in Canc. No. 92071706. The Answer contains a section entitled "Affirmative Defenses" that contains allegations substantively identical to that in Opp. No. 91249276. Our prior comments about these allegations, *see supra*, nn. 9 & 15, apply equally here.

²³ *See* 60 TTABVUE.

²⁴ *See* 61 TTABVUE.

²⁵ *See* 167 TTABVUE (Opposer's Confidential Trial Brief); 168 TTABVUE (Opposer's Redacted Trial Brief); 169 TTABVUE (Applicant's Trial Brief); 170 TTABVUE (Opposer's Reply Brief).

For the reasons explained in detail below, we conclude that confusion is unlikely between any of the FICO and FIDO marks. We therefore dismiss both oppositions and deny the petition to cancel.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved applications and registrations. In addition, Opposer introduced the following in its case-in-chief:

- The Confidential Declaration of Doug Clare, Opposer's Vice President for Fraud Security and Compliance Solutions, with attached confidential exhibits 31, 37, 40-42 (76 TTABVUE), as well as a redacted nonconfidential version of the Clare Declaration with the balance of the nonconfidential exhibits 1-30, 32-36, 43-83) (78-80 TTABVUE; 82-83 TTABVUE; 86 TTABVUE; 89-92 TTABVUE, 94 TTABVUE, 96-97 TTABVUE; 99-100 TTABVUE; 102 TTABVUE; 104-105 TTABVUE; 110 TTABVUE); and
- A Notice of Reliance attaching many documents (81 TTABVUE; 84-85 TTABVUE; 87-88 TTABVUE; 93 TTABVUE; 95 TTABVUE; 98 TTABVUE; 101 TTABVUE; 106-109 TTABVUE; 111 TTABVUE).

Applicant introduced the following:

- The Declaration of Andrew Shikiar, its Executive Director and Chief Marketing Officer, together with many exhibits (133-134 TTABVUE);
- The Declaration of Christina Hulka, its Executive Director and Chief Operating Officer, together with an exhibit (134-135 TTABVUE);
- The Declaration of Mark Keegan, a principal at a consulting firm for FIDO Alliance, who performed a consumer survey, together with three exhibits (136 TTABVUE);
- The Declaration of Elizabeth Votaw, who worked, inter alia, at third-party Bank of America from 1987-2018 and at third-party Wells Fargo from 2018-2021, and who, from 2014-2021, sat on Applicant's Board of Directors (137 TTABVUE); and

- A Notice of Reliance with attached nonconfidential exhibits 29-34, 36-48 (138 TTABVUE) and separately filed confidential exhibits 27-28, 35 (139-145 TTABVUE).

During its rebuttal period, Opposer introduced the following:

- The Rebuttal Declaration of Doug Clare (148 TTABVUE);
- The Declaration of Brian M. Sowers, a Principal at third-party Applied Marketing Science, Inc., a market research and consulting firm, with exhibits, in rebuttal to the Declaration of Mark Keegan (149 TTABVUE); and
- A Rebuttal Notice of Reliance with exhibits 132-153 (150 TTABVUE).

III. Statutory Entitlement to Opposition/Cancellation

The parties initially stipulated that “Opposer Fair Issac [sic] Corporation has standing to bring the claims in this proceeding. *See* Trademark Board Manual of Procedure (TBMP) §309.03(b).”²⁶ Section 309.03(b) concerns what we and the Federal Circuit used to call “standing” to bring an opposition or cancellation under Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 & 1064. Both statutes contain similar language limiting those who may institute an opposition or cancellation proceeding to “[a]ny person who believes that he would be damaged by the registration of a mark” (Section 13(a) and “any person who believes that he is or will be damaged ... by the registration of a mark” (Section 14). But we no longer say that these provisions concern “standing.” In the wake of the Supreme Court’s decision in *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061 (2014), we now call this requirement “statutory entitlement” or something

²⁶ 77 TTABVUE 2.

similar. *See, e.g., Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020) (noting that a challenge to “standing” to bring a Board proceeding really asks the question “[w]hether a party is entitled to bring or maintain a statutory cause of action”) (citing *Lexmark*, 109 USPQ2d at 2067; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062-63 (Fed. Cir. 2014)), *cert. denied*, 141 S. Ct. 2671 (2021). But it’s the same legal inquiry: whether the party who instituted the proceeding reasonably believes it will be damaged by the registration, as required by statute. *See, e.g., Austl. Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (“The statutory requirements to cancel registration of a mark under § 1064 are substantively equal to the statutory requirements to oppose the registration of a mark under § 1063: both require a party to demonstrate a real interest in the proceeding and a reasonable belief of damage.”) (citations omitted).

After this initial stipulation as to Opposer’s “standing,” the Board ruled that the “parties may not stipulate to a plaintiff’s standing [i.e., entitlement to bring an opposition and/or cancellation proceeding] in the absence of supporting facts.”²⁷ The

²⁷ *See* 113 TTABVUE 2 (bracketed notation added). “Whether a party is entitled to bring or maintain a statutory cause of action is a legal question.” *Corcamore*, 2020 USPQ2d 11277, at *4. While tribunals generally accept parties’ stipulations of fact (unless they appear contrary to the facts disclosed by the record), *see, e.g., Peter Letterese and Assocs., Inc. v. World Inst. of Scientology Enters.*, 533 F.3d 1287, 87 USPQ2d 1563, 1584 (11th Cir. 2008); *Mead’s Bakery, Inc. v. Comm’r*, 364 F.2d 101, 106 (5th Cir. 1966), stipulations on questions of law are not binding on the tribunal. *See, e.g., Swift & Co. v. Hocking Valley Ry. Co.*, 243 U.S. 281, 289 (1917); *Ideker Farms, Inc. v. United States*, 71 F.4th 964, 978 (Fed. Cir. 2023). To the extent statutory entitlement presents a mixed question of law and fact, such a stipulation similarly would not be binding on us because of the issue of law bound up in it. *See, e.g., Peter Letterese*, 87 USPQ2d at 1584 n.32; *Splunge v. Shoney’s, Inc.*, 97 F.3d 488, 492 n.2 (11th Cir. 1996);

parties obliged and stipulated to several facts, including that: (1) Opposer owns Registrations Nos. 2273432, 2573131, 2989390, and 4032019 on the Principal Register; (2) Applicant's challenged applications seek registration of the FIDO mark and Applicant owns U.S. Registration Nos. 4679315, 4682450, 4877885, 5141976 for the FIDO mark; and (3) Opposer Fair Isaac alleges and believes that there is a likelihood of confusion between its prior FICO mark and Applicant's FIDO marks and that Opposer believes that it will be damaged thereby.²⁸

To establish entitlement to institute a proceeding under the opposition or cancellation statutes, a plaintiff must demonstrate (i) an interest falling within the zone of interests protected by the opposition statute and (ii) proximate causation. *See, e.g., Corcamore*, 2020 USPQ2d 11277, at *4. Demonstrating a real interest in opposing or seeking to cancel registration of a trademark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at *7-8.

As noted, the parties stipulate to Opposer's prior pleaded registrations. The parties also stipulate that Opposer alleges and believes that Applicant's challenged FIDO marks create a likelihood of consumer confusion as to source in view of Opposer's registrations and that Opposer believes it will be damaged thereby.²⁹ These

Spangler v. Pasadena City Bd. of Educ., 519 F.2d 430, 435 n.4 (9th Cir. 1975), *vacated on other grounds*, 427 U.S. 424, 96 S. Ct. 2697, 49 L. Ed. 2d 599 (1976).

²⁸ *See* 117 TTABVUE. The stipulation also recites that Opposer owns unspecified "common law rights in the FICO mark." *See id.* at 2.

²⁹ *See* 35 TTABVUE 3-5 & Exhs. 1-11.

stipulated facts establish that Opposer is entitled to invoke the opposition provisions of Section 13. *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *7 (TTAB 2022) (pleaded registrations demonstrated entitlement to oppose on basis of likelihood of confusion); *Primrose Ret. Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (same).

As to the petition to cancel, Opposer's ownership of the pleaded registrations (all of which, except one,³⁰ are older than Applicant's existing registrations) support its plausible likelihood of confusion claim against the involved registrations, thereby showing that Opposer has a real interest in petitioning to cancel Applicant's registrations and a reasonable basis for its belief of damage. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

We therefore conclude that Opposer is entitled to invoke the opposition and cancellation proceedings in Sections 13(a) and 14, respectively.

IV. The Priority and Likelihood of Confusion Claim under Trademark Act Section 2(d), 15 U.S.C. § 1052(d)

Now that we have determined that Opposer is entitled both to bring an opposition proceeding against Applicant's applications and to petition to cancel Applicant's existing registrations, we turn to the other elements of a claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Section 2(d) prohibits registration of a mark that "so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned,

³⁰ The application that Opposer asserted—which since matured into Reg. No. 6901439—is the only one that post-dates Applicant's existing registrations.

as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

A. Priority

Under Section 2(d), an opposer must prove either ownership of a prior registration or priority of use. Where, as here, an opposer bases its opposition on its ownership of registered marks and has made the registrations of record, and the applicant has not counterclaimed to cancel them, Section 2(d) does not require proof of priority of use as to the marks and goods and services covered by the registrations. *See, e.g., Top Tobacco LP v. N. Atl. Op. Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974)); *see also Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) (“prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation”); *Itel Corp. v. Ainslie*, 8 USPQ2d 1168, 1169 (TTAB 1988) (“because of the existence of opposer’s valid and subsisting registration, it need not prove prior use as to the services recited therein”). Here, Opposer relies on several pleaded registrations, copies of which it has made of record.³¹ Applicant does not contest that any of these registrations are prior

³¹ *See* Clare Decl., 78 TTABVUE 7-11, 90, 92, 94, 96, 98-102, 104-05; Opposer’s Notice of Reliance, 88 TTABVUE 41, 43, 45, 47, 49-53. We note, however, that Opposer did not provide copies of the status or title of the registrations in either of the ways set forth in Trademark Rule 2.122(d)(2) (specifying submitted status and title copies through a notice of reliance offered during its testimony period or by making the copies exhibits to testimony taken during the party’s testimony period); *see also* TBMP § 704.03(b)(1). Opposer did submit the status and title copies as attachments to its trial brief, but that is improper. *See, e.g., Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 71345, at *2 (TTAB 2020) (exhibits attached to brief not considered); *Bass Pro Trademarks LLC v. Sportsman Warehouse, Inc.*, 89 USPQ2d 1844, 1848 (TTAB 2008) (no consideration given to exhibits attached to brief on the case where they

to the '010 Application. Thus, we find that Opposer has established priority as to its opposition proceedings.

Typically, in a cancellation proceeding in which adverse parties own registrations, the petitioner must prove priority of use. *See, e.g., Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). Here, in its trial brief, Applicant does not address the issue of priority. Nonetheless, Opposer must still establish priority to prevail in its cancellation proceeding. Because Opposer's Registrations Nos. 2273432, 2573131, 2714565, 2989390, and 4032019 for the mark FICO are of record, it may rely on the filing date of the underlying applications as a constructive use dates for purposes of priority. *See Trademark Act § 7(c), 15 U.S.C. § 1057(c); see also J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). Opposer filed the most recent of the applications that led to these registrations (Reg. No. 4032119) on February 25, 2009. This is prior to the October 22, 2015, filing date of Applicant's three attacked registrations. Applicant does not argue that it is entitled to an earlier priority date,³² so October 15, 2015, is earliest date on which Applicant

were not properly made of record during the time for taking testimony); *Life Zone Inc. v. Middleman Grp., Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008) ("Evidence submitted outside of the trial periods—including that attached to briefs—is untimely, and will not be considered."). Nevertheless, we note that Applicant neither objected to Opposer's failure to submit the status and title copies of the registrations through the proper means during the testimony period nor contested that Opposer owns these registrations and that they still exist. Further, as noted earlier, the parties have stipulated that "Fair Isaac owns U.S. Registration Nos. 2273432, 2573131, 2989390, and 4032019 for the FICO mark, U.S. Registration No. 2714565 for the MYFICO mark, all on the Principal Register." *See* 117 TTABVUE 2. In these circumstances, we too will consider these registrations as owned by Opposer and subsisting.

³² As noted, Applicant does not address priority. Applicant discusses its acquisition of a prior FIDO registration and application from Fiserv, Inc., in connection with its arguments about other issues in the case, *see, e.g.,* Appl. Br. at 2, 28-29, 169 TTABVUE 9, 35-36, but does not contest Opposer's priority based on that acquisition.

is entitled to rely. *Calypso Tech., Inc. v. Calypso Cap. Mgmt., LP*, 100 USPQ2d 1213, 1220 (TTAB 2011); *Hilson Rsch. Inc. v. Soc’y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1428 n.13 (TTAB 1993).

Thus, Opposer has established priority for purposes of all of these consolidated proceedings.

B. Likelihood of Confusion

“In opposition proceedings, the opposer has the burden of proving a likelihood of confusion by a preponderance of the evidence.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *1 (Fed. Cir. 2020) (citation omitted). The same is true in a cancellation proceeding. *See, e.g., Cunningham v. Laser Golf*, 55 USPQ2d at 1848; *West Fl. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1665-66 (Fed. Cir. 1994). To determine whether likelihood of confusion has been proved, we evaluate the factors listed in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (hereinafter, “*DuPont*”). *See, e.g., Stratus Networks*, 2020 USPQ2d 10341, at *1. Our analysis under *DuPont* “considers all ... factors for which there is record evidence but may focus on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1288 (Fed. Cir. 2016) (cleaned up; citations omitted); *see also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (cleaned up; citations omitted). We do not mechanically tally the number of factors supporting each party, *see, e.g., Citigroup Inc. v. Cap. City Bank Grp., Inc.*,

637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011), but instead weigh them together with the understanding that in any given case one or more factors may be more consequential than others. *See, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 1381, 2023 USPQ2d 451, at *4 (Fed. Cir. 2023) (“The weight given to each factor depends on the circumstances of each case.”) (citation omitted); *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 2022 USPQ2d 513, at *7 (Fed. Cir. 2022) (“Not all of the *DuPont* factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case.”) (internal quotation marks and citation omitted).

1. Preliminary organizational consideration

Since the *DuPont* analysis requires us to compare marks and Opposer asserts several registrations against several of Applicant’s applications and registrations, we need to determine the most efficient way to complete the required comparisons. If confusion is likely even between just one good or service at issue in an affected International Class in an asserted registration and one good or service in an application, that is enough to sustain an opposition as to the goods or services in the affected class in the application. *See, e.g., Bond v. Taylor*, 119 USPQ2d 1049, 1052-53 (TTAB 2016); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *see generally SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). With this in mind, and to potentially eliminate unnecessarily performing entire *DuPont* analyses on all permutations of the pleaded marks, we frequently try to discern which of the parties’ marks are closest to one another—both in terms of the

mark and the identified goods/services—and to train our analysis on them. If we find no likelihood of confusion as to them, then that finding has the potential to save us the need to assess those other permutations of asserted and challenged registrations and applications that differ more from one another in terms the marks, the identified goods and services, or other salient factors. If we do find likelihood of confusion as to the closest marks, we can then look at the next closest comparisons to determine if the additional difference(s) tip the calculus the other way. If so, the remaining, more different, mark comparisons become irrelevant. *See generally In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We start with the marks. There are three applications at issue in the '634 Parent Opposition, two of which include elements beyond the term FIDO, such as stylized typefaces and integrated designs. Only one, the '254 Application, is for the term FIDO in standard characters.³³ Since standard character marks can be displayed in any font or typeface, *see, e.g., Midwestern Pet Foods, Inc. v. Société des Produits Nestlé S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012) (“both marks use the standard character format, so any specific differences in design are not relevant”); *SquirtCo*, 216 USPQ at 939 (“the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”), focusing on a

³³ All of Applicant’s registrations at issue in the '706 Child Cancellation are also standard character marks. In contrast, the application at issue in the '276 Child Opposition is for FIDO in a stylized typeface with an incorporated design.

standard character version of a mark can eliminate the need to assess the impact of stylization or a design on the likelihood of confusion analysis.³⁴

Here, all three of Applicant’s applications in the ’634 Parent Opposition, including the standard character application (the ’254 Application), identify the same goods (devices and software in Class 9) and services (in Class 45).³⁵ The goods or services identified in Opposer’s asserted registrations differ from one another. The only one of Opposer’s FICO registrations that identifies goods (which include software within Class 9) is the ’019 Registration.³⁶ Similarly, the only asserted “FICO” registration that identifies services in Class 45 is the ’019 Registration. This suggests to us that it is good to start with the comparison of Applicant’s standard character ’254 Application.³⁷

³⁴ We also note that the design of the stylized FIDO marks are not so distinctive as to the create a commercial impression separate and apart from the word “Fido.”

³⁵ The ’383 Application, which is the subject of the ’276 Child Opposition, also identifies devices and software falling within Class 9 goods.

³⁶ The ’439 Registration, which issued in 2022 and is asserted in the two “child” proceedings but not in the “parent” proceeding, also identifies software products, but is for the mark ULTRAFICO, which is significantly more different than FICO from Applicant’s FIDO marks.

³⁷ In the ’276 Child Opposition, the only mark Opposer challenges is FIDO in a stylized typeface with an incorporated design, which would be an additional point of distinction with Opposer’s asserted mark. So that doesn’t displace Applicant’s ’254 Application as a candidate for the first likelihood of confusion analysis.

Finally, looking at the dispute in the ’706 Child Cancellation, all of the FIDO marks are standard character, but the services in Applicant’s ’315 and ’885 Registrations are further still from any registration Opposer is asserting. And, as will be explained below, one of the main disagreements between the parties is whether the kinds of hardware on which Applicant’s goods and services focus—devices that use biometrics, near field communication (NFC), USB and electronic key card devices—fall within or is near to the scope of the goods and services Opposer offers. One of the categories of goods identified in Applicant’s ’254 Application (“Systems comprising computer hardware and software for enabling authentication of the personal identity of computer users”) does not have such a limitation, but the Class 9 goods in Applicant’s ’976 Registration do. Thus, none of the challenged

So this opinion will first assess whether to sustain Opposer's opposition to Applicant's '254 Application based on Opposer's '019 Registration. If so, we will then broaden our analysis incrementally to include additional marks/goods/services, etc., to determine whether which, if any, of Applicant's applications or registrations survive Opposer's challenges. If not, we will try to leverage our findings in that first analysis, where appropriate, to streamline our resolution as to the other challenged applications and registrations. We will continue along this path until the entire dispute is resolved.

2. Assessment of the relevant *DuPont* factor as to the marks and goods in Applicant's '254 Application and Opposer's '019 Registration

a. *DuPont* factor 1 – similarities/dissimilarities in the marks

The first *DuPont* factor concerns “[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567. This is always is one of the most important considerations. *See, e.g., Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“Turning to the relevant *DuPont* factors, the ‘similarity or dissimilarity of the marks in their entireties’ is a predominant inquiry.”) (citation omitted). “Marks are compared along the axes of their ‘appearance, sound, connotation and commercial impression.” *Juice Generation, Inc. v. GS Enters. LLC*,

registrations at issue in the '706 Child Cancellation displaces the '254 Application as the best candidate to start our analysis.

794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015) (citation omitted); *accord In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017).

The parties appear to agree that FICO and FIDO are four-letter terms that look similar except that their third letters differ. Neither party argues that FICO is a recognized word in contemporary English.³⁸ There are at least two ways to pronounce it in American English, fee-koh or fi-koh.³⁹ While not a defined term in contemporary English, FIDO is recognized as a common cliché name for a dog and used as a dog name in conversation when generically referring to a dog.⁴⁰ There appears to be only one pronunciation of FIDO which, spelled phonetically, is “fahy-doh.”⁴¹

In sum, while the marks are similar in some parameters examined in the abstract, FIDO has a connotation that FICO does not and has a different second consonant sound (and may also be pronounced by some with a different first vowel sound). While each trademark case is unique and must be decided on its own facts, the evidence

³⁸ One of Opposer’s registrations (the ’432 Registration) says that it’s an “acronym for ... Fair Isaac & Company.” 78 TTABVUE 90. But Applicant does not argue that the relevant consumers perceive that connotation.

³⁹ 138 TTABVUE 1-2 (<https://Wordpanda.net/pronunciation/fico>).

⁴⁰ *See id.* at 85-87, 90-92. These articles state that the name is derived from Latin and means faithful or trusty, which are said to be characteristics of domesticated dogs.

⁴¹ *See id.* at 104 (<https://wordpanda.net/pronunciation/fido>). We accessed the webpage referenced in the record on November 21, 2023, and clicked on the link to hear the pronunciation, and the vowel in the first syllable was pronounced as a long “i,” like the “i” in “ice” or “fight.” See also the phonetic spelling key in <https://www.dictionary.com/e/key-to-phonetic-respelling/> (also accessed on November 21, 2023), of which we take judicial notice, which states that the phonetic shorthand notation “ahy” represents the bolded vowel sounds in “**I**, ice, hide, deny,” i.e., a long “i.” *See, e.g., B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted” for purpose of taking judicial notice).

here calls to mind our decision in *In re Reach Electronics, Inc.*, 175 USPQ 734 (TTAB 1972). There, we said:

“REAC” and “REACH” are literally words apart from each other. The one letter difference referred to by the examiner is quite significant herein because “REACH” is a commonly used dictionary word which possesses a meaning unlike “REAC” which is and would be recognized as a play on ‘react’ or ‘reactor’. And by reason thereof, “REACH” would be readily distinguishable from “REAC” in appearance, and it does not sound like “REAC” when spoken. Thus, the differences between the marks “REACH” and “REAC” are deemed sufficient to obviate any likelihood that purchasers would attribute the products sold thereunder to the same source.

Id. at 735.

On the evidence here, we think the differences between FICO and FIDO are significant enough to outweigh the similarities and that the difference in the resulting commercial impression weighs against a finding that confusion is likely. *Cf. In re Digirad Corp.*, 45 USPQ2d 1841, 1845 (TTAB 1998) (although DIGIRAY and DIGIRAD differed only by one letter, Board found that they had different connotations in the context of the case); *Safeway Stores, Inc. v. Sure Oil & Chem. Corp.*, 174 USPQ 477, 479 (TTAB 1972) (“While the marks ‘SAVEWAY’ and ‘SAFEWAY’ only differ as to one letter, they are nevertheless not identical and they do engender different commercial impressions due to the meanings of the words ‘SAVE’ and ‘SAFE’.”).

b. *DuPont* factors 2, 3, and 4 – similarities/dissimilarities in the goods/services, channels of trade, and customers

We consider the second, third, and fourth *DuPont* factors together. They concern the similarities and dissimilarities of the parties’ respective goods and services,

channels of trade, and customer classes, as well as the sophistication and care exercised by those customer classes, respectively. We think it makes sense to assess these three factors together here because Opposer's argument that the parties' goods and services are related (factor 2) includes an argument that the goods and services Applicant offers are within the "zone of natural expansion" of Opposer's business. As we explain below, the "zone of natural expansion" inquiry includes assessing the parties' channels of trade (as in *DuPont* factor 3) and who the parties' customers are (which is part of *DuPont* factor 4). So *DuPont* factors 2 – 4 are interrelated in this case.

We ultimately find that the goods and services are related in the general sense in that they both play a role in combatting fraud, Opposer's directly and Applicant's indirectly. But they are quite different in nature, in that Opposer's goods and services examine transactions after the fact based on data, whereas Applicant's simply restricts access to computer systems to people in possession of particular objects or credentials (irrespective of whether the access is for the purpose of engaging in a commercial transaction or some other purpose). We further find that Opposer has failed to prove its argument that Applicant's user-authentication goods and services were within Opposer's zone of natural expansion. The trade channels and classes of customers overlap, but the customers are quite sophisticated, careful purchasers. As such, they are less prone to casual purchasing behavior, which in turn decreases the potential for source confusion. We will now explain how we arrived at these findings.

We start by assessing the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *DuPont*, 177 USPQ at 567. This is the *DuPont* factor that consumes the biggest share of both parties’ briefing. “[T]he relevant inquiry considers if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 2022 USPQ2d 513, at *8 (Fed. Cir. 2022) (citation and internal quotation marks omitted). Generally, the more similar the goods or services, the less similar the marks need to be to make confusion likely, and vice versa. *See, e.g., ECI Div. of E-Sys., Inc. v. Environ. Commc’ns Inc.*, 207 USPQ 443, 450 (TTAB 1980); *see also Coach Servs.*, 101 USPQ2d at 1721 (“if the parties’ goods are closely related, a lesser degree of similarity between the marks may be sufficient to give rise to a likelihood of confusion.”) (citations omitted); *Century 21*, 23 USPQ2d at 876-77 (similarity of the marks should be assessed “through the lens of other *du Pont* factors,” including the parties’ services).

We generally “focus on the application and registrations rather than on real-world conditions, because the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application.” *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (citation omitted). But the goods and services identifications here are fairly technical, and some of them are phrased in vague terms. When that is the case, to better understand the goods and services and how they may relate to one another,

we deem it “appropriate to consider extrinsic evidence of use to determine the meaning of the identification of goods.” *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1354 (TTAB 2015) (citing *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *In re Trackmobile, Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990)); *cf. Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1304-05 (Fed. Cir. 2009) (court upheld factual findings based on statements registrant made during course of prosecution about the services in connection with which he used the mark). Here, both parties offer copious amounts of testimony and other evidence about the scope and meaning of the relevant products and services as identified in the applications and registrations at issue.

While Opposer’s identifications are lengthy and comprise many goods and services, Opposer’s trial brief bases its arguments only on a few of them, presumably the ones Opposer believes are most similar to Applicant’s goods and services. We will follow Opposer’s lead (after all, it is Opposer’s claims we are adjudicating) and will focus, at least initially, on the respective goods and services that Opposer’s brief highlights.⁴²

All of Applicant’s applications at issue identify “authentication” of computer users. While Opposer argues that one of more of its prior registrations covers “authentication,” the term “authentication” does not appear in the list of goods and

⁴² See 168 TTABVUE 34-36 (table comparing certain of the goods and services in Opposer’s registrations to certain of the goods and services in Applicant’s applications and registrations).

services for any of these registrations—an absence that Applicant highlights.⁴³ Opposer counters that it provides “authentication” as part of its services and goods for “managing fraud [and] identity theft.”⁴⁴

In Class 9, Opposer zeros in on the following goods Applicant identifies in its applications: “Systems comprising computer hardware and software for enabling authentication of the personal identity of computer users” (which appears in the ’254, ’299, and ’417 Applications); and “computer software for authentication of user identification and device attestation” (which appears in the ’383 Application). Opposer compares these to “software and enterprise software applications for use in monitoring, tracking, detecting, preventing and managing fraud in credit transactions, identity theft and other types of fraud in connection with credit grantors, financial and lending institutions, and insurance companies, insurance providers and insurance payors,” which is one of the many goods listed in Opposer’s ’019 Registration.⁴⁵

In Class 42, Opposer’s trial brief targets the following services Applicant identifies in its ’383 Application: “Providing user authentication and device attestation backend services using public-key cryptographic technology in e-commerce transactions; computer security services, namely, providing a secure binding process between a

⁴³ See 169 TTABVUE 8, 32.

⁴⁴ See 168 TTABVUE 36-37.

⁴⁵ See *id.* at 34. Opposer also highlights and “computer software, namely, software to automate service account password management and retrieval by enabling authentication of personal identity using biometric information” (which appears in Applicant’s ’976 Registration), see *id.* at 34-35, but since this is further away from the goods Opposer highlights in its ’019 Registration, we will put that aside for the moment.

device and a backend server for authentication of user identification and device attestation; computer security services in the nature of authentication of user identification and device attestation services for authorizing financial transactions.”⁴⁶ It compares these to Class 42 services listed in its ’019 Registration—“providing temporary use of online nondownloadable software for use in monitoring, tracking, detecting, preventing and managing fraud in credit transactions, identity theft and other types of fraud in connection with credit grantors, financial and lending institutions, and insurance companies, insurance providers and insurance payors; ... development of customized software.”⁴⁷

In Class 45, Opposer highlights the following services Applicant identifies: “Providing user authentication services in e-commerce transactions, namely, providing a secure binding process from a user device to a server backend for assured user authentication” (which appears in Applicant’s ’450 Registration) and the nearly identical description that appears in the ’254, ’299, and ’417 Applications: “Providing user authentication services in online transactions and e-commerce transactions; Providing a secure binding process from a user device to a server backend for assured user authentication.” Opposer’s trial brief compares these services to its “Fraud detection services using data warehousing, data mining and predictive modeling software, all for use in monitoring, tracking, detecting, preventing and managing fraud and identity theft in the fields of credit fraud, credit card fraud, debit card

⁴⁶ 168 TTABVUE 35-36.

⁴⁷ *See id.*

fraud, check fraud, identity theft, mortgage fraud, and banking fraud,” which is listed in Opposer’s ’019 Registration.⁴⁸

Noticeably, all of the challenged goods and services specify “authentication” of “users.” In contrast, none of the goods and services of its own that Opposer highlights mention authentication of users. Though it does not use the word “authentication” in the description of the goods it highlights in its ’019 Registration, Opposer’s trial brief emphasizes that its highlighted goods and services include “authentication” as part of “fraud prevention,”⁴⁹ which is mentioned as a purpose in its goods and services identifications.

We note initially that it is well settled that it’s not enough that one can find a broad category or term that encompasses both parties’ goods and/or services. *See, e.g., In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007) (“It is true that applicant’s goods, as identified, include a Portland cement based patch for use in repairing wall and floor surfaces, while the cited registration covers a chemical filler for use in the cosmetic repair of polyolefin surfaces, and therefore they can both be broadly described as preparations for repairing surfaces. However, to demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly

⁴⁸ *See id.* at 36. Opposer also compares various of its Class 36 services with Applicant’s “Financial services, namely, transaction processing services for credit cards, debit cards, and cardless electronic payments” (listed in Applicant’s ’885 Registration) and “Financial transaction services, namely, providing secure commercial transactions in the nature of authentication of user identification and device attestation services for authorizing financial transactions,” listed in Applicant’s ’383 Application. *See id.* at 35. We will put these aside for the moment.

⁴⁹ *See, e.g., id.* at 17, 37.

describe the goods.”) (citations omitted); *Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (“[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.”); *UMC Indus., Inc. v. UMC Elecs. Co.*, 207 USPQ 861, 879 (TTAB 1980) (“Under these circumstances, the fact that one term, such as ‘electronic’, may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.”); *Harvey Hubbell Inc. v. Tokyo Seimitsu Co.*, 188 USPQ 517, 520 (TTAB 1975) (“In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties.”) (citation omitted); *see also Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Cir. 2002) (“[A] broad general market category is not a generally sound reliable test of relatedness of products.”).

So we will need to look beyond the broad phrases that Opposer uses (“preventing fraud” or “fraud prevention”) to determine the relationship, if any, between the parties’ goods and services. We now turn to the testimony and other evidence to understand what “authentication” means in Applicant’s applications and to determine whether there is testimony or other evidence backing Opposer’s argument that, notwithstanding the absence of the term “authentication” in any of its prior registrations, the “authentication” services Opposer says it provides are, in fact,

identical to, overlapping with, or otherwise related to Applicant's authentication products and services.

In his declaration, Opposer's witness Doug Clare, Opposer's Vice President for Fraud Security and Compliance Solutions, talks about authentication in terms of FICO's "fraud prevention" and "fraud solutions" goods/services.⁵⁰ His declaration states that, before 2019, when Opposer acquired third-party company EZMCOM (more on that later), the kind of "authentication" FICO's products and services performed were "transaction authentication" or to "adjudicate a transaction."⁵¹ Another example Mr. Clare gave was "assess[ing] the validity of someone who is filing a new account application."⁵² He testified that "the term 'authentication' was not widely used to describe products that contained the functionality of verifying and validating the identity of the person conducting a transaction until about 5-10 years ago, when it started becoming a commonly used term of art. Before that, products that provided verification of the identity of an individual making a financial transaction were often called 'validation,' 'verification' or 'identity management' solutions."⁵³

What is apparent from Mr. Clare's use of "authentication" in the context of FICO's "fraud prevention" area is that it applies to determine if individuals who have engaged in transactions are who they say they are. In other words, the person is

⁵⁰ See, e.g., 78 TTABVUE 14, 16, 19, 21, 22, 24.

⁵¹ See, e.g., *id.* at 17, 18.

⁵² See *id.* at 23.

⁵³ See *id.* at 14.

authenticated after the person initiates the transaction. In his deposition, Mr. Clare pointed specifically to FICO's "Falcon"-brand products and services as the FICO goods and services that first performed (starting around 2001-02) the "authentication" he identified.⁵⁴ He testified that, at this time, the fraud prevention products and services analyzed transactions in which individuals had engaged and then "validated and verified, authenticated if you will against that [individual's] profile" and the institution involved "can then determine based on that authentication or verification whether they wish to do some kind of step up, or, um, second, third, fourth factor check against the transaction."⁵⁵ After acquiring a third-party company named Adeptra in 2012, FICO's "authentication" expanded somewhat:

Q. Did Fair Isaac offer any authentication tools or products before it acquired EZMCOM in late 2019?

A. Yes. Um, our -- um, our fraud product line at FICO, FICO Falcon Fraud Manager, FICO Application Fraud Manager, um, all of these offerings are based on behavioral profiles look to authenticate, measure the likelihood of the authenticity of the transaction being adjudicated by the financial institution. ... I think equally as relevant from an authentication perspective would be the products that FICO acquired with our 2012 acquisition of Adeptra. Adeptra had built a business on providing step-up authentication and multifactor authentication that would ride on top of FICO's Falcon adjudication -- adjudication of transaction. When Falcon would, um, determine a high likelihood of a transaction not being authentic, the Adeptra suite of products would then step in and perform other multifactor authentication, uh, processes, reaching out to the consumer, uh, the -- the initiator of the transaction via email, text, SMS, um, or the bank's mobile banking app, um, and perform certain KBA knowledge-based authentication services

⁵⁴ See 152 TTABVUE 23, 25, 26-27, 61-63, 109, 157-58.

⁵⁵ See *id.* at 26-26.

to allow the bank to further authenticate the transaction and ensure that the, um, party making it is legitimate.⁵⁶

Later, he elaborated that “FRM or Fraud Resolution Manager is one of the FICO customer communication services we acquired by Adeptra, call out to consumers for validation or KBA services.”⁵⁷ An example of a “KBA” authentication would be reaching out to the person who just completed the transaction and asking “Did you make this transaction, yes or no?”⁵⁸ Opposer’s client or customer then has to make a decision based on the information Opposer’s products or services provide as to whether to allow, pause, or cancel the transaction.⁵⁹ Mr. Clare concluded that Opposer’s Falcon products and services “assess the veracity of the transaction.”⁶⁰

It is therefore clear that, when Opposer uses the term “authentication” in this case—not in its registrations, because the word doesn’t appear there—it’s talking about authenticating the identity of a person who has engaged in a transaction.

In contrast, Applicant’s reference to “authentication” in its description of goods and services “is focused on confirming that proper requirements are met to permit access to a system.”⁶¹ The sort of authentication performed by Applicant’s goods and services is essentially an alternative to using a password to gain access to a system.⁶²

⁵⁶ *See id.* at 61-63

⁵⁷ *See id.* at 84.

⁵⁸ *See id.* at 85-86.

⁵⁹ *See id.* at 109, 162-63.

⁶⁰ *See id.* at 150.

⁶¹ Declaration of Andrew Shikiar (Applicant’s Executive Director and Chief Marketing Officer), 133 TTABVUE 16.

⁶² *See id.*

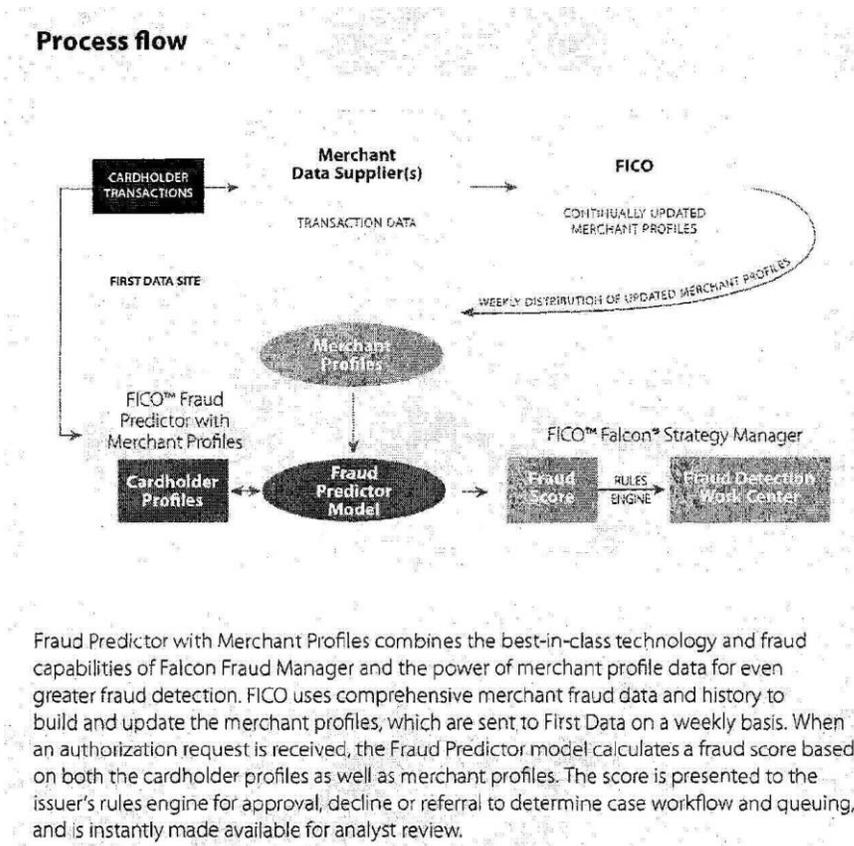
To be sure, Applicant's witness Mr. Shikiar, its Executive Director and Chief Marketing Officer, testified that failure to authenticate (in the sense of Applicant's access management products and services) could lead to data breaches by unauthorized individuals, and that, in turn, data breaches could lead not only to theft of corporate assets, but also could be put to fraudulent uses.⁶³ But that strikes us as significantly different from goods and services that, like Opposer's, are directly aimed at fraud prevention.

As we sift through the voluminous testimony and evidence, we see two basic differences between Opposer's fraud-related products and services and Applicant's access-control products and services. One granular difference is the focus of the parties' products and services. Applicant's products and services concern making sure only authorized users have access to a business's or other organization's sensitive computer assets. Opposer's fraud-related products, on the other hand, are agnostic about who is allowed to access to computer assets but instead are concerned about whether purchasing, borrowing, and other consumer transactions—some but perhaps not all of which are performed by consumers on computers—are being engaged in by the person whom the transactor purports to be.

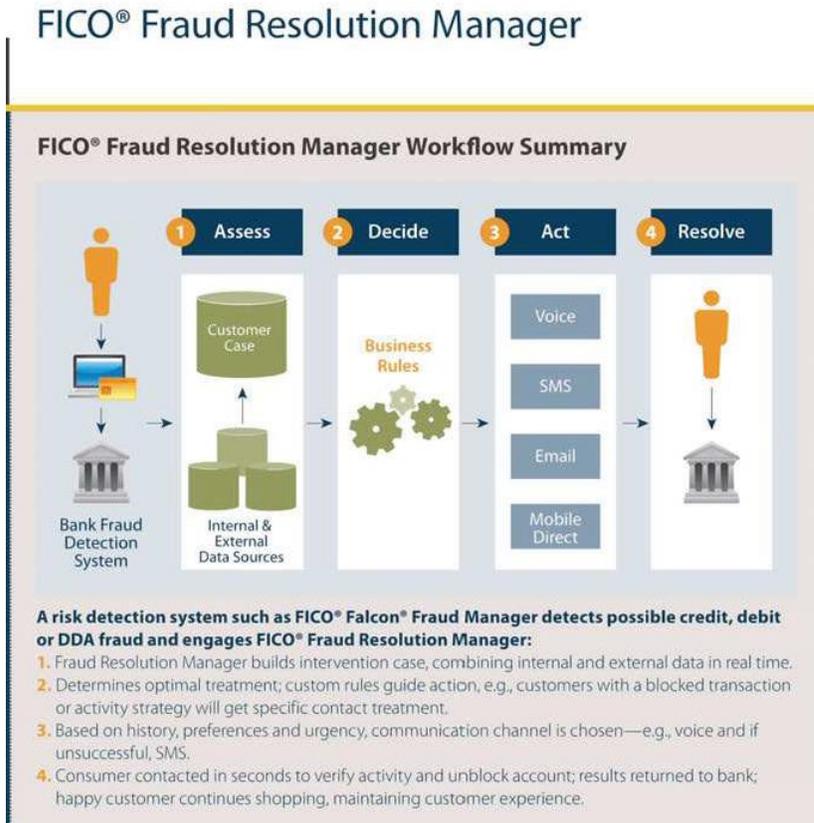
A second difference is temporal. Applicant's products and services deny access altogether to computer assets to person who do not possess the proper credentials for access to that asset. In contrast, Opposer's anti-fraud-related products and services all involve authenticating a given transaction. These analytics and actions kick in

⁶³ See 81 TTABVUE 98-99, 262-63 (Shikiar Deposition).

after the transaction has occurred, which, in computer-initiated transactions, itself occurs **after** the user has gained access to the computer. This is shown graphically by the following flow chart, which shows Opposer’s Falcon Fraud Predictor kicking in downstream of the “cardholder transactions”:



See 78 TTABVUE 217; see also *id.* at 221. Another graphic from a later fraud-directed product shows a similar sequence, which starts with a person engaging in a transaction, and then the company with whom the consumer has engaged in the transaction employing Opposer’s Fraud Resolution Manager to “assess,” “decide,” “act,” and “resolve” any identified potential fraud:



78 TTABVUE 329.

We find it significant that Opposer published an article on Opposer’s blog, written by Mr. Clare, warning that “customer identity management” (i.e., what Opposer’s products and services do) is different than “access management” (i.e., what Applicant’s goods and services do).⁶⁴ Specifically, the article states that what Opposer’s products and services (at the time) were designed to do is allow clients and customers to implement “the business strategy and processes by which an organization establishes who a customer is and ensures that activity on their accounts is carried out by them.”⁶⁵ The article then contrasts this with “identity and

⁶⁴ See 153 TTABVUE 25-26.

⁶⁵ See *id.* at 25.

access management,” which it describes and distinguishes as follows: “a framework of policies and technologies for ensuring that the proper people in an enterprise have the appropriate access to technology resources.”⁶⁶ The article ultimately notes that “[a]ccess management may be seen as an IT security topic, whereas customer identity management may be led more by financial crime or compliance professionals and is likely an important focus for customer experience.”⁶⁷

We note in addition that a type of evidence of relatedness that we commonly see in other cases is missing in this case. If there is evidence that third parties offer the goods or services of both parties under one mark, that may show that the respective goods and/or services are related in the sense that it shows that the relevant consuming public may be conditioned to see them offered by the same source. *See, e.g., Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020). The absence of this evidence is conspicuous here. *Cf. Calypso Tech., Inc. v. Calypso Cap. Mgmt., LP*, 100 USPQ2d 1213, 1221 (TTAB 2011) (“There is simply no evidence of record that shows that ‘computer software for use by financial institutions for core processing and control’ and ‘equity investment management and fund services’ are ever offered by a single company.”).

Opposer argues in the alternative that the user authentication goods and services that Applicant offers are within the “zone of natural expansion” of Opposer’s fraud

⁶⁶ *See id.*

⁶⁷ *See id.* at 26.

prevention goods and services.⁶⁸ The “zone of natural expansion” argument is another way to show that nonidentical goods or services are nevertheless related because purchasers might reasonably expect the senior user to expand into offering the same goods or services as the junior user. *See, e.g., Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015). We generally consider a number of nonexclusive factors when assessing such arguments:

1. Whether the second area of business (that is, the subsequent user’s area of business into which the first user has or potentially may expand) is a distinct departure from the first area of business (of the prior user), thereby requiring a new technology or know-how, or whether it is merely an extension of the technology involved in the first area of business;
2. The nature and purpose of the goods or services in each area;
3. Whether the channels of trade and classes of customers for the two areas of business are the same, so that the goodwill established by the prior user in its first area of business would carry over into the second area; and
4. Whether other companies have expanded from one area to the other.

Mason Eng’g and Design Corp. v. Mateson Chem. Corp., 225 USPQ 956, 962 (TTAB 1985); *see also Sky Int’l AG v. Sky Cinemas LLC*, No. 21-1575, 2021 WL 5985363, 2021 USPQ2d 1233, at *5 (Fed. Cir. Dec. 17, 2021) (nonprecedential). For short, we will refer to these factors as the “*Mason* factors.” As can be seen, the *Mason* factors overlap considerably with the *DuPont* factors that compare the goods and services, the trade channels, and the customer classes.

⁶⁸ *See* 168 TTABVUE 7, 8, 27, 33.

Applicant notes that the time period for assessing whether the expansion in question would be natural is when the junior user first began to offer the goods and services that the senior user claims are within its natural zone of expansion.⁶⁹ We agree. *See, e.g., Mason Eng'g*, 225 USPQ at 962. The dates of first use of Applicant's mark in commerce listed in the challenged applications, about which there is no dispute, is the 2013-14 timeframe.⁷⁰

Opposer, who bears the burden to prove its claims, does not address the first *Mason* factor: whether expanding to what Applicant does would require new technology. It seems clear to us, however, that the claimed expansion would require technology that is different from the data-driven predictive technology that is explained in Opposer's promotional material and referenced in the identifications of services in its registrations.

As to the second *Mason* factor, we have already discussed the nature of the respective goods and services in Opposer's registrations and in Applicant's applications and registrations. As noted, while the goal of both parties' goods and services includes could be stated broadly as integrity of use of computer assets for legitimate commercial transactions, they are quite different in their particulars.

The third *Mason* factor is where we get into the parties' channels of trade and classes of customers (which are relevant likelihood of confusion factors under *DuPont* as well, *see* 177 USPQ at 567). So, in the following, our discussion will do double duty

⁶⁹ *See* 169 TTABVUE 35.

⁷⁰ *See* 81 TTABVUE 144-45 (Shikiar Deposition).

because it will apply not only to the *DuPont* analysis but also to the *Mason* factor analysis.

Because there are no express limitations in the respective goods and services set forth in the applications and registrations, we presume that their goods and services are marketed through all the normal trade channels, to all the usual customers, for the goods and services in question. *See, e.g., Coach Servs.*, 101 USPQ2d at 1722. Because the goods and services here are not ordinary consumer goods where the “normal” trade channels and “usual” customers are obvious, we look to the evidence concerning how, and to whom, the parties market the products and services at issue. Opposer’s witness Mr. Clare testified:

With respect specifically to fraud prevention and authentication products and services offered in connection with the FICO Mark, FICO’s relevant purchasers include financial institutions (banks, insurance companies, etc.), credit card issuers, payment processing companies, payment networks (e.g. MasterCard, Visa), retailers, and other entities that process financial transactions (airlines, hotels, telecommunication companies, mobile companies, entertainment companies, etc.).⁷¹

As to the specific individuals within those companies, Mr. Clare explained:

Due to the importance and criticality of fraud prevention and authentication products and services, the decision to purchase these products and services is generally made by “C-level” executives like the Chief Risk Officer, Chief Fraud Officer, Chief Information Security Officer, and occasionally the Chief Product Officer. In many instances, the Chief Financial Officer is also part of the purchasing decision. Most of the time, FICO is interfacing with the C-level and its direct reports, one or two levels down. ...

The purchasing decision is also not made—or influenced—by very many people. In large banks, there may be 3-4 executives who make

⁷¹ 78 TTABVUE 38.

the decision to purchase authentication solutions; in smaller banks it may be 1 executive.⁷²

Applicant's witness, Mr. Shikiar, testified that that Applicant's mark "is used in connection with protocol standards based on public key cryptography that allows online users to authenticate themselves without the need for passwords."⁷³ Further, as to specific customers, he testified that:

FIDO authentication products and services are not limited to the financial services and financial transactions industries. Rather, FIDO authentication protocols can be utilized in a wide variety of fields that have traditionally relied on passwords. FIDO Alliance members include leading computer operating system providers Microsoft, Apple, and Google, who offer FIDO authentication capabilities to log in and access functions in Windows, Android, Mac OS, and iOS operating systems, and the U.S. Government, which working through the Office of Management and Budget (OMB) to provide FIDO authentication capabilities to log into government websites, such as the USPTO's forthcoming enhanced myUSPTO account.⁷⁴

He explained that Applicant "does not manufacture products itself. Rather, it licenses the use of its FIDO marks to member organizations that seek to implement quality goods and services that comply with the FIDO authentication protocol standards."⁷⁵ He specifically noted that Applicant's licensees include electronic device manufacturers, hardware security key/hardware authenticator manufacturers, software security specialists, biometric component specialists, government agencies, service providers (such as Amazon, Visa, Mastercard, eBay, Rakuten, and Facebook),

⁷² See *id.* at 39-40.

⁷³ 133 TTABVUE 10.

⁷⁴ See *id.* at 12.

⁷⁵ See *id.* at 11.

as well as banking institutions.⁷⁶ He testified further that Applicant is a “Nonprofit Mutual Benefit Corporation” whose Board of Directors comprise, in large part, representatives from large tech, communications, and Internet commerce companies who are interested in developing industry standards “to enable log-ins designed around public key cryptography that didn’t require traditional passwords.”⁷⁷ That is to say, Applicant’s company is run, in part, by representatives of some of its customer companies and organizations.

As to the characteristics of the particular individuals within those types of companies, he explained that:

The majority of target consumers for FIDO branded products and services are mid-to-large size companies that focus on technical and Information Technology (IT) issues. A key target within such companies would be members of the technology teams that focus on security and compliance, such as Identity and Access Management (IAM) Engineers, Chief Information Security Officers (CISOs), Chief Technology Officers (CTOs), and other IT professionals who have an influence on the purchasing decisions within their companies.

FIDO branded products and services are also marketed to software developers and integrators who may want to integrate password-less authentication protocols into their consumer interfaces.”⁷⁸

From the testimony of Messrs. Clare and Shikiar, it appears to us that the parties’ channels of trade are similar, in that the types of companies and institutions they

⁷⁶ See *id.* at 15-16.

⁷⁷ 133 TTABVUE 3-4.

⁷⁸ See *id.* at 13

target overlap.⁷⁹ Within those target companies, Opposer tends to target top-level executives on the business side, and Applicant tends to target top-level people on the technical side, though the individuals they target overlap to a degree, with both parties targeting Chief Information Security Officers. Both Applicant's and Opposer's customers, at an individual level, are highly sophisticated individuals who exercise commensurate care in purchasing (and in Applicant's case, licensing) such sophisticated products and services. Indeed, in Applicant's case, some of its customer companies provide individual to serve on Applicant's Board.

Opposer argues that we need to assess the case from the viewpoint of the "least sophisticated consumers" and that, to do that, we need to consider the general public, because they "encounter" Opposer's goods and services.⁸⁰ By "encounter," Opposer's brief makes clear that it is using the term to expand the inquiry beyond prospective purchasers of the goods and services that are the subject of this proceeding to include, for example, individuals who see their FICO credit score, any employee of a company who utilizes a FIDO-licensed nonpassword authentication protocol to use the company's computers, and anyone else who happens just to see either of the marks. We do not agree that this expansion is appropriate. What we take into account are the "least sophisticated **purchasers**" of the relevant products or services. *See, e.g., Stone Lion Cap. Partners*, 110 USPQ2d at 1163 ("Board precedent requires the

⁷⁹ In his rebuttal declaration, Mr. Clare points out that two companies on Applicant's Board, Mastercard and Wells Fargo, actually "bought products containing authentication services [sic] from FICO." 148 TTABVUE 9.

⁸⁰ *See* 168 TTABVUE 40-42.

decision to be based ‘on the least sophisticated potential purchasers.’”) (citation omitted); *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992) (“we believe that, at least in the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential ‘purchasers’ are confused”) (citations omitted). And Opposer’s trial brief does not argue that these individual consumers are within the relevant classes of potential consumers for the specific products and services at issue.⁸¹ The evidence is to the contrary.

Opposer cites *ProQuest Information & Learning Co. v. Island*, 83 USPQ2d 1351, 1356 (TTAB 2007), for the proposition that we must take into account members of the general public because they could use the products and services at issue here.⁸² We do not think *ProQuest* can or should be read that expansively. That case involved an application for goods that specifically referred to a software product that, while sold to institutions, specifically noted that it was also “for use by individuals,” and “for use by ... students at the high school ... level[].” *See id.* at 1352. Here, by contrast, the descriptions of the goods and services at issue have no analogous language specifying

⁸¹ To be sure, there are a couple of conclusory paragraphs in Mr. Clare’s Declaration asserting that Opposer sells the fraud prevention-related software and services on which it bases its case to individual consumers (e.g., its Falcon Fraud Manager, FICO Application Fraud Manager), but they lack detail and, more importantly, are not corroborated by anything else Opposer points us to in the record. *See* 78 TTABVUE 38 (¶ 85), 39 (¶ 94). In contrast, Mr. Clare testifies at great length about how and how much it sells to its corporate and institutional customers. In these circumstances, we are unconvinced that Opposer sells, or tries to sell, any significant amount of the fraud prevention services it asserts here to individual consumers.

⁸² *See id.* at 42.

that goods and services are meant for use by members of the general public or any evidence that the general public, if it “sees” the parties’ marks in connection with, or uses, the products or services here cares about the source. *See, e.g., Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 21 USPQ2d at 1393 (“[O]pposer urges the likelihood that persons who use opposer’s data processing and telecommunications services at work and who buy batteries at retail stores would be confused as to source. The extension of ‘relevant persons’ to this group is untenable in this case. First, it has not been shown that such persons would even be aware of who provided the data processing services to their employer.”). Like other aspects of the likelihood of confusion inquiry, we will assess sophistication based on the product and service markets defined by the applications and registrations themselves.

Having determined the classes of customers and the trade channels, we now assess the last part of the third *Mason* inquiry: whether, in light of those findings, “the goodwill established by the prior user in its first area of business would carry over into the second area.” *Mason*, 225 USPQ at 962. As we previously noted, Mr. Clare has warned, on Opposer’s website, that what Opposer’s products and services do is different from what Applicant’s goods and services do. Thus, despite the overlap in the targeted companies and even within those companies, in the targeted (sophisticated) individuals, we find it hard to infer from the particular record here that “the goodwill established by the prior user in its first area of business would carry over into the second area.” *See Mason*, 225 USPQ at 962.

The fourth and final *Mason* factor is whether other companies have expanded from offering the goods and services of one party to the other's. *See id.* As mentioned, there is no evidence of other companies offering both parties' goods and services, let alone expanding from Opposer's goods and services to Applicant's goods and services.

Weighing the evidence here under the relevant *Mason* factors, Opposer's evidence fails to persuade us that Applicant's goods and services were within Opposer's zone of natural expansion in the 2012-13 timeframe.

Apparently understanding that the *Mason* factors do not help it much, Opposer argues that the incremental development of its Falcon fraud prevention products and services naturally culminated in its 2019 acquisition of EZMCOM and the integration of EZMCOM's biometric authentication services.⁸³ It argues that "[i]t was reasonable for [Opposer] to extend its services through the acquisition of EZMCOM and purchasers could reasonably assume the services emanate from the same source, namely, [Opposer]."⁸⁴ But there is no evidence that any third parties have expanded in the way Opposer suggests, and Opposer had previously expressed its view that biometrics—one of the types of access management encompassed by Applicant's goods and services—was risky because it was subject to hacking and theft and, once hacked and stolen was difficult to remediate.⁸⁵

⁸³ *See* 170 TTABVUE 19-21. Biometrics is one of the specific means of user authentication identified in Applicant's applications.

⁸⁴ *See id.* at 21.

⁸⁵ *See* 153 TTABVUE 20-21.

Moreover, when a “zone of natural expansion” argument depends in significant part—as Opposer’s does here—on the senior user’s acquisition of a third-party company, we need to be especially careful:

Before the doctrine of natural expansion may be invoked by opposer, it must be shown that the new goods, i.e., the extension of the line of business from that which pre-existed applicant’s arrival, evolved from the manufacturing and marketing activities of opposer and did not result from the acquisition of a new business by a diversifying company. The burden is on opposer to present evidence that is persuasive of the fact that the new business represents an expansion of, and not merely an unrelated addition to, the business that opposer conducted prior to the first use of applicant’s mark on the goods for which applicant is seeking a registration. ... Here ... opposer’s expansion was not a “natural” expansion, but was a result of peculiar circumstances, namely, opposer’s acquisition by [a third-party company]. Opposer has not met its burden of demonstrating that a provider of computer programming services involving data processing would normally or reasonably expand to include computer-aided design and manufacturing, or that purchasers would generally expect such services to emanate from the same source. Accordingly, opposer cannot bootstrap its later entry into the computer-assisted design and manufacturing area in order to interfere with applicant’s intervening rights stemming from applicant’s adoption and use of [the mark] EDSA for “computer programs for electrical distribution system analysis and design,” rights which were established at a time that opposer was involved only in the data processing field.

Elec. Data Sys. Corp., 23 USPQ2d at 1463-64 (citations omitted; paragraph breaks omitted); *see also ILC Indus., Inc. v. ILC, Inc.*, 175 USPQ 623, 626 (TTAB 1972) (expansion is not natural where it is more in the nature of diversification through acquisition). In short, while Opposer ultimately expanded, in 2019, into providing authentication in the nature of access management, we are unpersuaded by the evidence and arguments here that such expansion proceeded naturally as an

outgrowth of the fraud-related products and services Opposer had been offering up through 2012-13 and indeed, up until the very time it acquired EZMCOM.

To sum up our findings on the second, third, and fourth *DuPont* factors (as well as Opposer's natural expansion argument), we find the parties' goods and services related in the general sense that Opposer explicitly targets potentially fraudulent transactions soon after the consumer engages in them and Applicant's goods could be said to play a part—on the front end where a computer system is first accessed by a user—in targeting fraud (as well as other goals). But as one looks at the language in the Opposer's '019 Registration and in Applicant's '254, '299, and '417 Applications through the lens of the explanatory testimony and other evidence, the seeming relationship dissolves because they focus on different activities and employ different means to achieve their respective ends. Opposer has not persuaded us that Applicant's goods and services were within its zone of natural expansion at the time Applicant began offering its products and services. We find that the evidence falls short of showing that “a reasonably prudent consumer would believe that [their] non-competitive but [generally] related goods ... derive from the same source, or are affiliated with, connected with, or sponsored by the same trademark owner.” *See In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001) (citations omitted).

The parties' channels of trade appear to be similar, in the sense that the sales of their complex, business-oriented products and services would require intense interaction with their targeted companies, primarily medium-to-large sized, before

sales were consummated. In other words, this is a case where purchasing care is heightened. This would tend to support a finding that confusion is likely. The customer companies themselves overlap, and, to a degree, so do the types of people at those companies and institutions within them that the parties interact with. But these targeted individuals are people with enormous responsibilities within their organizations and are sophisticated purchasers who know their companies' business and technology needs. Thus, while the evidence under the *DuPont* factor that assesses both the "buyers to whom sales are made" and also "[t]he conditions under which" those sales are made ("i.e., 'impulse' vs. careful, sophisticated purchasing") pull in opposing directions, the evidence here convinces us that sophisticated purchasing is the overriding consideration. This factor, on balance, supports a finding that confusion is not likely. *Cf. Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1412-13 (TTAB 2010) (that both parties targeted hospitals and that there was some potential overlap in hospital personnel involved in decisions to purchase parties' products was outweighed by careful, sophisticated purchasing such personnel would engage in).

c. *DuPont* factor 5 – the fame (i.e., strength) of the FICO mark

The fifth factor mentioned by the *DuPont* Court is the "fame of the prior mark (sales, advertising, length of use)." 177 USPQ at 567. This factor is not a binary "famous or not" issue. "Fame for purposes of likelihood of confusion is a matter of degree that varies along a spectrum from very strong to very weak." *Coach Servs.*, 101 USPQ2d at 1720 (cleaned up; citations omitted). "A mark with extensive public

recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1698 (Fed. Cir. 2018)) (citation and internal quotation marks omitted). Marks that are famous or very strong “are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (citation omitted). “Although fame alone cannot overwhelm the other *DuPont* factors as a matter of law, fame deserves its full measure of weight in assessing likelihood of confusion.” *Id.* at 1898.

“[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont* factor is the class of customers and potential customers of a product or service, and not the general public.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1695-96 (Fed. Cir. 2005). Thus, in *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734 (TTAB 2014), we held that while IKEA was “famous for retail store services in the field of furniture, housewares and home furnishings,” the company had not specifically proved it was famous as to other goods and services identified in its asserted registrations, *see id.* at 1740, such as “Canned and frozen meat, fish and shellfish; jams, preserves and pickles.”

In its trial brief, Opposer does not argue that Applicant’s goods and services are related to all of the goods and services listed in the registrations it asserted. As shown above, many of those registrations—especially the ’019 Registration—concern scores of goods and services that Opposer does not discuss here. Significantly, Opposer does

not assert that its credit scoring services (and credit-score-related products) are related to Applicant's goods. By narrowing its arguments as to which of its goods and services are related to Applicant's goods and services, Opposer has also necessarily limited the scope of the "like" products or services, i.e., the "specific product markets," that are the focus of the fame/strength inquiry. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) ("[A] mark's renown within a specific product market is the proper standard.") (citing *Palm Bay Imports*, 73 USPQ2d at 1695-96).

Here, the specific market upon which Opposer bases its likelihood of confusion arguments is, most significantly, its fraud prevention goods and services. Much of Opposer's arguments about the strength, however, are based on evidence relating to its credit score-related services. It cites, for example, that it sells tens of billions of consumers' FICO credit scores each year, and that 240 million people have free access to their FICO credit scores.⁸⁶ Other evidence upon which Opposer relies lumps together all of Opposer's goods and services (including the credit-score-related services and everything else), such as citing its total U.S. sales of all products and services and citing its total advertising and promotional expenditures across all its products and services.⁸⁷

⁸⁶ *See* 168 TTABVUE 27-28.

⁸⁷ *See id.* at 28. Similarly, Opposer's evidence of its trademark enforcement efforts is generalized and does not differentiate among the goods and services that may have been involved. *See id.*

Applicant does not dispute that FICO is a well-known mark in connection with credit scoring products and services,⁸⁸ but points out that there is no evidence in the record directed to the fame or strength of the FICO mark in connection with its fraud related products and services, which are the basis of its likelihood of confusion claims.⁸⁹ We agree. The “specific product [or service] market” at issue in this case is Opposer’s targeted customers for the fraud prevention-related services upon which Opposer bases its likelihood of confusion claim. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734; *Palm Bay Imports*, 73 USPQ2d at 1695-96; *Inter IKEA*, 110 USPQ2d at 1740. They are the consumers who are alleged to likely be confused by Applicant’s products and services. The generalized evidence Opposer highlights in its trial brief simply does not address the renown of Opposer’s mark in that market, leaving us with no basis that we can discern how to find, as Opposer urges, that its mark is famous or strong as to the relevant services it is asserting in this case.

Applicant does not argue that the FICO mark is weak although, puzzlingly, it argues that this factor ought nevertheless to weigh in its favor.⁹⁰ We do not agree. But none of Opposer’s marks were registered on the basis of acquired distinctiveness

⁸⁸ 169 TTABVUE 41.

⁸⁹ *See id.* at 41-42.

⁹⁰ *See* 169 TTABVUE 41-42. Applicant does not argue, for instance, that Opposer’s FICO mark is conceptually or commercially weak due to third-party registration or use, respectively. *Cf. Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (“The purpose of introducing evidence of third-party use is to show that customers have become so conditioned by a plethora of such similar **marks** that customers have been educated to distinguish between different such marks on the bases of minute distinctions. Third-party use is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”) (cleaned up; citations omitted).

under Section 2(f), 15 U.S.C. § 1052(f). As a consequence, they are presumed to be inherently distinctive. *See, e.g., Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 2021 USPQ2d 1069, at *12 (Fed. Cir. 2021). We therefore find that the FICO mark, as it concerns the fraud prevention goods and services upon which Opposer bases its likelihood of confusion claim, should be accorded no more and no less than the normal strength accorded any inherently-distinctive registered mark. We therefore find this factor to be neutral.

d. *DuPont* factors 7 & 8 – evidence of actual confusion and/or the significance of the lack of such evidence

The seventh and eighth factors listed in *DuPont* are “(7) [t]he nature and extent of any actual confusion [and] (8) [t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” 177 USPQ at 567. It is of course true that proof of actual confusion is not required to prove that confusion is likely. *See, e.g., Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990) But if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Registrant under its marks, the absence of any reported instances of confusion may well indicate that confusion is unlikely. *See, e.g., Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1560-61 (Fed. Cir. 2001); *G.H. Mumm & Cie. v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1428-29 (TTAB 2018); *Citigroup, Inc. v. Cap. City Bank Group*, 94

USPQ2d 1645, 1660-62 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

As to the length of time the parties have been offering the goods and services identified in the subject applications and registrations, Applicant's dates of first use in commerce of its challenged FIDO marks is 2013-14.⁹¹ There is no dispute that Opposer was using its marks for fraud-related products and services before then, So, conservatively, the parties have been using the marks in question for at least around nine (9) years.

There is no dispute that Opposer is a large company whose business is national in scope. Applicant as well is a large company with national scope.⁹² More specifically, as noted, there is significant overlap in the type of companies to whom the parties have sold (or, in Applicant's case, licensed) their respective goods and services. Indeed, some of the specific companies overlap.

We deem it significant that two such sophisticated, large, national companies have been out in the marketplace dealing with the same types of corporate customers and, in some instances, the same companies, and yet neither is aware of any evidence that, at any time over the last nine years, any of their actual or potential customers has been confused as to the source of the parties' respective goods and services. Indeed,

⁹¹ See 81 TTABVUE 144-45 (Shikiar Deposition).

⁹² See 93 TTABVUE 274-77, 456-59 (listing FIDO members as of Nov. 2016, Nov. 2015, respectively) (confidential document); 133 TTABVUE 111-12 (describing Applicant's growth); *id.* at 13 (describing Applicant's marketing means), 14-15 (listing examples of Applicant's member companies); 134 TTABVUE 374-77 (Applicant's 2013 founding press release listing founding member companies); *see id.* at 379-80 (press release about new member companies); 135 TTABVUE 3 (listing Applicant's member companies and organizations in 2022).

the unusual circumstances here make the absence of such evidence stand out. We find that the seventh and eighth *DuPont* factors weigh heavily in this case against a finding that confusion is likely.

- e. *DuPont* factor 9 – the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark)

The ninth *DuPont* factor considers “[t]he variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).” *DuPont*, 177 USPQ at 567. If a party in the position of plaintiff uses its mark on a wide variety of goods or services, then purchasers are more likely to view a defendant’s related goods or services under a similar mark as an extension of the plaintiff’s line. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *14 (TTAB 2020). This factor may favor a finding that confusion is likely even if the goods or services are not obviously related, but typically has less impact if the parties’ goods or services in issue are already identical or closely related. *See, e.g., Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1271 (TTAB 2003). We have already assessed both the relationship between the parties’ goods and services and, as part of that inquiry, Opposer’s “zone of natural expansion” argument. We therefore need to be careful not to simply double count those findings here.

Opposer emphasizes the “hundreds” of goods and services it offers under the FICO mark, and argues that they constitute a “wide variety.”⁹³ While some of Opposer’s registrations, like the ’019 FICO Registration and Reg. No. 6901439 for ULTRAFICO, contain lengthy recitations of goods and services, they are all in the business,

⁹³ *See* 168 TTABVUE 43-44.

financial, and credit spaces. While Opposer appears to have an intense presence in those spaces, we do not see anything about those listed goods and services—beyond the arguments it already made and we considered under the second *DuPont* factor as to the relationship between the goods and services and the zone of natural expansion—that would suggest that that this factor has independent additional significance here. For example, Opposer does not make any argument that it has significant prior common law use of FICO for goods and services beyond those already listed in the asserted registrations. We find this factor neutral.

f. *DuPont* factor 10 – the market interface between applicant and the owner of a prior mark

The tenth *DuPont* factor assesses the “market interface” between the parties. *See* 177 USPQ at 567. It lists a number of possible particular types of interfaces to look for, such as whether the parties have some sort of agreement addressing potential confusion, or whether the prior user has engaged in conduct amounting to laches or estoppel. *See id.*⁹⁴ Opposer argues that the tenth factor weighs in its favor. It notes that there are no relevant agreements between the parties.⁹⁵ It also argues that it did not delay in enforcing its rights against Applicant.⁹⁶ But the absence of a consent agreement is irrelevant, as is a denial of delay (at least when Applicant is not

⁹⁴ Applicant pleaded estoppel and acquiescence, but, as noted earlier, waived these defenses by not pursuing them at trial. *See supra* n.8.

⁹⁵ *See* 168 TTABVUE 44-45.

⁹⁶ *See id.* at 45.

pursuing a laches defense). None of the circumstances Opposer alludes to bears on likelihood of confusion. This factor is neutral.

- g. *DuPont* factor 11 – the extent to which applicant has a right to exclude others from use of its mark on its goods or services

The eleventh *DuPont* factor considers “the extent to which applicant has a right to exclude others from use of its mark on its goods.” *DuPont*, 177 USPQ at 567; *see also Monster Energy Co. v. Lo*, 2023 USPQ2d 87, at *42-43 (TTAB 2023). Here, Applicant makes no argument about its right to exclude others. Opposer argues that this factor weighs in Opposer’s favor because this factor “focuses on the strength of the applicant/registrant’s mark.”⁹⁷ But, as we recently made clear in *Monster Energy Co. v. Lo*, the eleventh factor “does not consider the strength or fame of the applicant’s mark in the same way the scope of protection is determined for the prior user under *DuPont* factor five.” 2023 USPQ2d 87, at *46. Rather, it “may consider any successful trademark enforcement activity in which the applicant has engaged, the purpose is not to assess the scope of protection of the applicant’s mark (as in the fame analysis for the prior user’s mark), but to discern the marketplace reality and consumer perception of Applicant’s use.” *Id.* at *47. Because neither party has offered at trial any evidence that we see as relevant to this factor, we deem it neutral in this case.

⁹⁷ *See id.*

h. *DuPont* factor 13 – any other established fact probative of the effect of use

The thirteenth *DuPont* factor is a catch-all that assess “[a]ny other established fact probative of the effect of use.” 177 USPQ at 567. Bad faith in adopting and using a mark is, when proved, one such fact. *See, e.g., QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 USPQ2d 35, at *3-4 (Fed. Cir. 2021). Opposer argues that Applicant’s adoption of the mark FIDO was in bad faith in light of the facts that: (1) Applicant admitted that, at the time of adoption (i.e., in the timeframe spanning roughly 2009 through 2012) the FICO mark was well known in connection with consumer credit scores; (2) in 2013 Applicant commissioned a comprehensive trademark clearance search in which a reference to Opposer’s FICO marks was disclosed; (3) Applicant later filed the subject trademark applications anyway; and (4) after Opposer objected, Applicant considered changing its mark but ultimately decided against it.⁹⁸

Applicant presented uncontradicted testimony that, prior to commencing operation, the potential members of the consortium Applicant intended to launch were considering the name FAST IDENTITY ONLINE, but one member convinced the others to shorten it to the acronym FIDO (i.e., **F**ast **I**dentit**y** **O**nline), which also was said to have the benefit of the Latin root “fidelis” and thus connoted “verify” or “true.”⁹⁹

⁹⁸ *See* 168 TTABVUE 46-48.

⁹⁹ *See* 133 TTABVUE 4 (Shikiar Declaration); *see also* 81 TTABVUE 129-30 (Shikiar Deposition).

In this context, however, “bad faith’ requires something more than mere knowledge of a prior similar mark. It requires an intent to confuse.” *Id.* at *4 (citations omitted). Adopting a mark with knowledge of a senior user’s mark, even if the senior user’s mark was listed in a trademark search, does not amount to bad faith (i.e., an intent to confuse). *See, e.g., Sweats Fashions v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). Nor does the fact that Applicant considered but rejected changing its mark after Opposer objected provide, without more, a basis to infer bad faith. As Professor McCarthy notes, continued use of a mark after receiving either a “cease and desist letter” or a lawsuit does not supply a basis to infer bad faith (i.e., intent to confuse) because, without more, that decision may just as likely reflect “rational business decision” that the objecting party’s accusation was “without a legally supportable basis.” J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23.120 (5th ed.) (Dec. 2023 update).

Accordingly, we find the thirteenth factor neutral.

- i. *DuPont* factor 12 – the extent of potential confusion, i.e., whether de minimis or substantial

The twelfth *DuPont* factor discusses “[t]he extent of potential confusion, i.e., whether de minimis or substantial.” *DuPont*, 177 USPQ at 567. We consider this last of all in this case because Opposer argues simply that “[t]his factor is essentially a summation of the other factors” and, since Opposer believes those factors weigh in its favor, this factor should count in its favor too.¹⁰⁰ Opposer misunderstands this factor.

¹⁰⁰ *See* 168 TTABVUE 48.

We have already made findings all the other *DuPont* factors raised by the parties. The twelfth factor is a separate factor. In cases where we find some factor or factors relatively more important, we simply weigh or balance them more heavily in the final step of determining the collective indication of all the relevant factors as to whether confusion is likely. *See, e.g., In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *7 (Fed. Cir. 2023). If we were simply to add up the other factors to make a twelfth factor finding and then add the twelfth factor into the final *DuPont* weighing step, we would be double counting.

We note that Opposer did not put in the kind of evidence we have previously considered under the twelfth factor. For example, in *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1205 (TTAB 2009), we assessed under the twelfth factor that “the goods involved here are the type of goods that would be marketed to and purchased by significant numbers of purchasers,” which did not support the applicant’s argument that the potential for confusion was *de minimis*. And in *Toro Co. v. Torohead Inc.*, 61 USPQ2d 1164, 1171 (TTAB 2001), we looked at, *inter alia*, “the highly technical nature of applicant’s goods, and the limited number of potential purchasers,” which favored the applicant in that case. Opposer does not make either type of argument here.¹⁰¹

The twelfth *DuPont* factor is neutral.

¹⁰¹ While the kind of evidence noted in the *Toro* case seems like it might plausibly be argued to be present here, Applicant did not advance any argument that the twelfth factor weighed in its favor.

j. Weighing the relevant *DuPont* factors as to Applicant's '254 Application and Opposer's '019 Registration

Our last step is to weigh the findings we have made on the individual *DuPont* factors together to determine whether confusion is likely or unlikely. *See, e.g., Charger Ventures*, 2023 USPQ2d 451, at *7. In so doing, we are cognizant that this is not a simple task of mechanically tallying up how many factors support each party, but instead reflects how important the factors are relative to one another in this particular case, i.e., how heavily each factor weighs in one or the other party's favor under the particular circumstances. *See, e.g., Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (“Citigroup’s approach of mechanically tallying the *DuPont* factors addressed is improper, as the factors have differing weights.”); *Charger Ventures*, 2023 USPQ2d 451, at *4 (“In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis.”) (citation omitted).

Here, while the marks have some similarities, FIDO has a connotation that FICO does not, has a distinctly different-sounding second consonant, and may be pronounced with a different first vowel sound. We think the differences outweigh the similarities and that the marks’ different commercial impressions weigh against a finding that confusion is likely. The goods and services, while related in the general sense that they both play a role in combatting fraud, writ large, are quite different in nature in that one party’s goods and services examine transactions after the fact based on data and the other’s simply restricts access to computer systems to people in possession of particular objects or credentials (irrespective of whether the access is

for the purpose of engaging in a commercial transaction or some other purpose). And the proof falls short of showing that Applicant's user-authentication goods and services were within Opposer's zone of natural expansion when Applicant began using its mark in commerce. The trade channels and classes of customers overlap, but the customers are quite sophisticated, careful purchasers, and thus less prone to the sort of casual purchasing behavior that could increase the potential for source confusion. Opposer has not proved its mark is famous or entitled to more expansive protection in the relevant market than the average inherently distinctive mark.

Despite about nine (9) years of transacting business with overlapping target companies as potential customers (and even having some of the same companies as customers), there is not even one instance of reported confusion on behalf of any actual or potential customer. Given the size and sophistication of the parties, the fact that this litigation has been going on for so long, and the fact that this case does not deal with inexpensive consumer items where consumer motivation to report confusion might be reduced, we deem this especially significant in this case.

We found the remaining factors (the ninth, tenth, eleventh, twelfth, and thirteenth) to be neutral.

On balance, we conclude that confusion is unlikely as between Applicant's '254 Application and Opposer's '019 Registration. The factor we think is most significant on the evidence and in the circumstances of this case is that there are no known instances of confusion. Also significant is the difference in the marks' connotations and the sophistication of the corporate consumers and care that the highly-placed

individuals who purchase (or, in Applicant's case, license) the business-oriented products and services here. The fact that there is only a modest relationship between the goods and services also supports our conclusion. These factors outweigh the overlap in trade channels and customers and the modest relationship between the goods and services.

3. Assessment of the relevant *DuPont* factors as to the marks and goods as between Applicant's '254, '299, and '417 Applications and Opposer's other registrations

As mentioned, Applicant's '254, '299, and '417 Applications all contain the same identified goods and services. The only differences between the '254 Application and the other two is that the marks in the other two are in a stylized typeface, and the '417 Application also claims color. These additional points of differentiation as to Opposer's '019 Registration don't further differentiate them from Opposer's standard character mark in the '019 Registration, however, because Opposer's standard character registration entitles it to use the registered mark in any typeface or color it wants. *See, e.g., Squirtco*, 216 USPQ at 939 ("the argument concerning a difference in type style is not viable where one party asserts rights in no particular display"). But while we cannot consider Applicant's '299 and '417 Applications further away from Opposer's '019 Registration, all findings we made concerning Applicant's '254 Application apply fully to them. Thus, we conclude that confusion is unlikely as between Applicant's '299 and '417 and Opposer's '019 Registration.

We will now compare Applicant's '254, '299, and '417 Applications with the other registrations Opposer asserted against them. Opposer's Registration No. 2989390 for

FICO in standard characters covers only goods in Class 9, namely: “Computer software in the field of credit scoring for use in creating and implementing business decision processes, risk management, evaluating credit ratings, score computation, score strategy and management and credit marketing in the field of financial services, insurance, telecommunications and retail industries.” These goods are further from Applicant’s Class 9 goods than the goods we assessed in Class 9 as to Opposer’s ’019 Registration. And all the other factors are the same. So we easily conclude that confusion is unlikely as between Applicant’s ’254, ’299, and ’417 Applications and Opposer’s ’390 Registration.

Opposer’s Registration No. 2273432 for FICO in standard characters is limited to “consultation services in the field of financial information, namely, providing credit scoring services” in Class 36. These services, too, are further from any of Applicant’s Class 9 goods and Class 45 services than the goods and services we assessed Opposer’s ’019 Registration. And all the other factors are the same. So we conclude here as well that confusion is unlikely as between Applicant’s ’254, ’299, and ’417 Applications and Opposer’s ’432 Registration.

Opposer’s Registration No. 2573131 for FICO in standard characters covers services in Class 35 described as “Business information services; information storage and retrieval in the field of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, portfolio management, communications management and data management; statistical forecasting and analysis; business consultation, preparing

business reports and management consultation.” It also identifies “Financial analysis and consultation; financial information provided by electronic means; risk management; consultation on debt recovery and collection” in Class 36 and “Education and training in the field of modeling, scoring and analytics, marketing and solicitation, account origination, account management and customer management, risk management, portfolio management, communications management and data management” in Class 41. Applicant’s ’254, ’299, and ’417 Applications list no even arguably overlapping or comparable services, and the other factors would appear to be essentially the same. Certainly Opposer does not argue otherwise in its trial brief, thus waiving any arguments about these services in Applicant’s ’254, ’299, and ’417 Applications. *See, e.g., In re Google Techs. Holdings, LLC*, 980 F.3d 858, 2020 USPQ2d 11465, at *3-4 (Fed. Cir. 2020) (argument not pursued is forfeited). We therefore conclude that there is no likelihood of confusion as between Applicant’s ’254, ’299, and ’417 Applications and Opposer’s ’131 Registration.

Opposer’s registration for MYFICO in standard characters, Reg. No. 2714565, is for a mark that is further away from Applicant’s FIDO mark than the FICO mark we examined above, so the first *DuPont* factor weighs even more heavily against a likelihood of confusion. Opposer’s trial brief does not argue that any of the services listed in its ’565 Registration are identical or even related to any goods or services in Applicant’s ’254, ’299, and ’417 Applications.¹⁰² Any such argument is therefore

¹⁰² Opposer’s trial brief compares its ’565 Registration only to Applicant’s ’383 Application and ’885 Registration.

forfeited. *See, e.g., Google Techs. Holdings*, 2020 USPQ2d 11465, at *3-4. We therefore conclude that there is no likelihood of confusion as between Applicant's '254, '299, and '417 Applications and Opposer's '565 Registration.

This completely resolves the dispute in Opposition No. 91225634, and Applicant's '254, '299, and '417 Applications will therefore proceed to registration.

4. Assessment of the relevant *DuPont* factors as to the marks and goods as between Applicant's '383 Application and Opposer's registrations (the '276 Opposition)

Opposition No. 91249276 concerns Applicant's Application Ser. No. 88120383 to register **fido** for goods and services in several classes. As to the authentication devices and authentication software in Class 9 and the authentication services in Class 42, all but two of our findings on the *DuPont* factors in the parent opposition apply to the '276 Opposition, except for the comparison of the marks and the actual confusion-related findings. In this case, the marks are more dissimilar than in the '276 Opposition because **fido** further includes a design element (where the "i" is portrayed as a stylized human extending an arm to the viewer's left) that Opposer's asserted registrations do not have. *See, e.g., In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018) (while a senior user's standard character registration can cover any typeface or color, it does not include additional design elements); *see also In re Viterra Inc.*, 671 F.3d 1358 101 USPQ2d 1905, 1910-11 & n.4 (Fed. Cir. 2012). Neither party has reported any actual confusion, but we note that the '383 Application is an intent-to-use application and the parties have not alerted

us as to whether it yet has been used in commerce and, if so, for how long and under what circumstances.

Thus, as to the ultimate weighing of the *DuPont* factors as applied to the Class 9 goods and the Class 42 services, we give additional weight to the increased dissimilarities between the marks and find factors seven and eight neutral. On balance, we think that the greater differences in the marks and the neutrality of the actual confusion factors is a wash, so we conclude that confusion is unlikely as to the Class 9 goods and Class 42 services in the '383 Application.

Opposer's trial brief makes no argument that confusion is likely as to Applicant's Class 35 association services in the '383 Application. We therefore hold that any such argument is forfeited. *See, e.g., Google Techs. Holdings*, 2020 USPQ2d 11465, at *3-4.

The Class 36 services in the '383 Application are: "Financial transaction services, namely, providing secure commercial transactions in the nature of authentication of user identification and device attestation services for authorizing financial transactions." The table in Opposer's trial brief compares these services to the Class 36 services in its '131 and '019 Registrations, which both recite "financial information provided by electronic means" and "risk management."¹⁰³ Opposer's argument that these specific services are related is rolled into the argument it made as to all the goods and services in the parent '634 Opposition: that Opposer provides goods and services designed to help companies sniff out fraudulent transactions and stop them

¹⁰³ *See* 168 TTABVUE 35.

as soon as possible after they occur.¹⁰⁴ We believe our findings on factors 2 (including the zone of natural expansion argument), 3, and 4 apply equally here. Opposer also asserts its '439 Registration for ULTRAFICO, again focusing on its identification of “financial information provided by electronic means” and “financial risk management.” Because the ULTRAFICO mark is even further away from the mark in the '383 Application than the other marks as to which we have concluded that confusion is unlikely, that conclusion applies even more forcefully here. We therefore conclude that confusion is unlikely as to the Class 36 services in the '383 Application.

Because we find and conclude that confusion is unlikely as to any of the registrations asserted against the '383 Application, we dismiss the '276 Opposition.

5. Assessment of the relevant *DuPont* factors in Cancellation No. 92071706

Cancellation No. 92071706 concerns Applicant's four registrations for FIDO in standard characters: 4679315, 4682450, 4877885, and 5141976.

To begin with, we do not see that Opposer's trial brief asserts that any of the services listed in Applicant's '315 Registration are likely to cause confusion as to source in view of any of Opposer's registrations. We therefore hold that any such claim is forfeited. *See, e.g., Google Techs. Holdings*, 2020 USPQ2d 11465, at *3-4. We will enter judgment denying cancellation as to Applicant's '315 Registration.

Applicant's Registration No. 4682450 is for FIDO in standard characters and identifies the following Class 45 services: “Providing user authentication services in

¹⁰⁴ *See id.* at 36-39

e-commerce transactions, namely, providing a secure binding process from a user device to a server backend for assured user authentication.” This is almost identical, albeit slightly narrower, than the Class 45 services identified in all three applications we considered in the parent ’634 Opposition. In its trial brief, Opposer compares the ’450 Registration only to its own ’019 Registration, which we previously assessed in the ’634 parent Opposition as to almost identical Class 45 services in Applicant’s three applications. Our findings and ultimate conclusion that confusion is unlikely thus apply here, and we will deny cancellation as to Applicant’s ’450 Registration.

Applicant’s Reg. No. 4877885 is for FIDO in standard characters for services in Class 36 identified as “Financial services, namely, transaction processing services for credit cards, debit cards, and cardless electronic payments.” In its trial brief, Opposer’s table comparing various of its registrations to various of Applicant’s applications and registration places the services in Applicant’s ’885 Registration side-by-side with excerpts from the listed services in two of its FICO registrations (the ’131 Registrations and the ’019 Registration) that identify, inter alia, “financial information provided by electronic means” and “risk management.”¹⁰⁵ Opposer’s trial brief does not otherwise argue or explain how the respective services offered by the parties are related. This is manifestly insufficient to present the issue for our decision. In an adversary proceeding like this one, it is not the Board’s responsibility to make the parties’ arguments for them. We therefore deem Opposer to have forfeited this claim. *Cf. SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 78

¹⁰⁵ See 168 TTABVUE 35.

USPQ2d 1097, 1103 (Fed. Cir. 2006) (arguments “adverted to in a perfunctory manner, unaccompanied by some effort at developed argumentation, are deemed waived”) (citation omitted); *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) (“A skeletal ‘argument’, really nothing more than an assertion, does not preserve a claim. Especially not when the brief presents a passel of other arguments. ... Judges are not like pigs, hunting for truffles buried in briefs.”) (citations omitted).

In any event, we fail to discern, from the face of the compared service descriptions, how processing credit card payments is related to providing financial information or risk management. Thus, our findings in resolving the Opposer’s attack on Applicant’s parent ’634 Opposition apply even more forcefully here, where there is no relationship that we can discern between the compared registrations. We will deny cancellation as to Applicant’s ’885 Registration.

Finally, Applicant’s ’976 Registration for FIDO in standard characters identifies “computer software, namely, software to automate service account password management and retrieval by enabling authentication of personal identity using biometric information; near field communication (NFC) technology-enabled readers and devices, namely, mobile phones; USB computer access control keys; electronic key cards.” Opposer’s brief compares this software only to certain software in its ’019 Registration identified as “software and enterprise software applications for use in monitoring, tracking, detecting, preventing and managing fraud in credit transactions, identity theft and other types of fraud in connection with credit grantors, financial and lending institutions, and insurance companies, insurance

providers and insurance payors.”¹⁰⁶ In attacking Applicant’s ’254, ’299, and ’417 Applications in the parent ’634 Opposition, Opposer asserted these same services in its ’019 Registration against the more general description of software in those three applications but did not challenge any of the software in Class 9 that specified a particular type of authentication device or means, such as software for user authentication through biometric, near field communication (NFC) technology, or USB devices. Applicant’s ’976 Registration, however, is limited to authentication software for specific types of authentication means.

Opposer’s trial brief does not address how the specific types of software identified in Applicant’s ’976 Registration are related to the software it highlights in the description of the ’019 Registration, except to the extent of the arguments we already resolved concerning *DuPont* factor two (and the zone of natural expansion) in the parent ’634 Opposition. Thus, our findings on all the relevant factors and our ultimate conclusion that confusion is unlikely apply at least equally as to Applicant’s ’976 Registration. We therefore will likewise deny cancellation as to Applicant’s ’885 Registration.

V. We need not rule on Opposer’s evidentiary objections

After the parties submitted their trial evidence, Opposer filed three motions to strike the following evidence submitted by Applicant:

- The testimony declaration of Elizabeth Votaw;¹⁰⁷

¹⁰⁶ See 168 TTABVUE 34-35.

¹⁰⁷ 147 TTABVUE.

- Evidence of Applicant’s assignment of an application and a registration from Fiserv, Inc., for the mark FIDO;¹⁰⁸ and
- The opinion testimony of Applicant’s survey expert, Mark Keegan.¹⁰⁹

The Board elected to defer its ruling on these motions until final deliberations.¹¹⁰

Opposer’s trial brief maintains each of these evidentiary objections and urges the Board to strike the subject evidence.¹¹¹ We find it unnecessary to rule on these motions. We did not find it necessary to consider, nor did we consider, any of this evidence in our analysis resolving the claims in this case. We therefore do not need to rule on these motions to strike. *See, e.g., Tri-Star Mktg., LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007) (“[W]e have not found it necessary to rely on any of the three remaining items [subject to motions to strike] in reaching our decision. Therefore, we need not consider the hearsay and relevancy objections in regard to those items.”).

VI. Conclusion

Decision: Oppositions Nos. 91225634 and 91249276 are dismissed. Cancellation No. 92071706 is denied.

¹⁰⁸ 159 TTABVUE.

¹⁰⁹ 160 TTABVUE.

¹¹⁰ *See* 157 TTABVUE (deferring a ruling as to Ms. Votaw’s testimony); 166 TTABVUE (deferring a ruling on the motions to strike evidence relating to the Fiserv, Inc., assignments and the proffered expert testimony of Mr. Keegan).

¹¹¹ *See* 168 TTABVUE 50-51 & appendices A-C thereto (168 TTABVUE 59-113).